117-336

TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1885.

No. 165.

THE YALE LOCK MANUFACTURING COMPANY,
APPELLANT,

vs.

JAMES SARGENT.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR THE SOUTHERN DISTRICT OF NEW YORK.

FILED NOVEMBER 7, 1882.

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1 *Suit No.* 2.

[L. S.] The President of the United States of America to the Yale Lock Manufacturing Company, Greeting:

You are hereby commanded that you personally appear before the judges of the circuit court of the United States of America for the southern district of New York, in the second circuit court, in equity, on the first Monday of September, A. D. 1872, wherever the said court shall then be, to answer a bill of complaint exhibited against you in the said court by James Sargent, and do further and receive what the said court shall have considered in that behalf. And this you are not to omit under the penalty on you of two hundred and fifty dollars.

Witness Honorable Salmon P. Chase, Chief Justice of the Supreme Court of the United States, at the city of New York, on the 15th day of July, in the year one thousand eight hundred and seventy-two, and of the Independence of the United States of America the ninety-seventh.

KENNETH G. WHITE, *Clerk.*

JAMES H. DAY, *Sol'r.*

The defendant is required to enter appearance in the above cause in the clerk's office of this court on or before the first Monday of September, 1872, or the bill will be taken *pro confesso* against it.

K. G. W., *Clerk.*

2 (Endorsed:) I hereby certify that on the 17th day of July, 1872, at New York city, in my district, I personally served the within subpœna upon the within-named Yale Lock Manufacturing Company by exhibiting to J. D. Brown, agent, the within original, with the seal of the court thereon, and at the same time leaving with him a copy thereof. Dated New York, Sept. 2nd, 1872. Geo. H. Sharpe. J. Tenney, dep. U. S. marshal, S. dist. of N. Y. Filed Sept. 6, '72.

3 United States Circuit Court, Southern District of New York.

In Equity.

JAMES SARGENT, Plaintiff,
vs.
THE YALE LOCK MANUFACTURING COMPANY, Defendants. } Case No. 2.

To the honorable the judges of the circuit court of the United States within and for the southern district of New York:

James Sargent, of Rochester, in the State of New York, lock manufacturer, brings this his bill of complaint against The Yale Lock Manufacturing Company, a corporation organized under the laws of the State of Connecticut, having a place of business at number 1 Barclay street, in the city of New York, in the southern district of New York.

And thereupon your orator complains that heretofore, to wit, in or before the year 1870, your orator, being a citizen of the United States, made a new and useful invention of an improvement in

4 permutation locks, which said improvement was not known

or used by others before the invention and discovery thereof by your orator; and thereupon, your orator having in all things duly complied with the requirements of the laws of the United States in this behalf, original letters patent of the United States were in due form of law issued to your orator from the Patent Office of the United States, bearing date on the 4th day of January, A. D. 1870, numbered 98622, whereby there was granted to your orator, his legal representatives and assigns, for the term of fourteen years, the full and exclusive right and liberty of making, using, and vending his said new improvement, as exhibited in his model deposited in the Patent Office and intended to be described and claimed in the specification and drawings annexed to the said original letters patent, which said right is now vested in your orator as the sole owner of the legal title to the said letters patent. Of all which proceedings and the title of your orator in and to the said letters patent, your orator will offer proof according to law on the hearing of this bill.

And your orator believes, and charges the fact to be, that your orator was the original and first inventor and discoverer of the improvement and the several combinations and things described and claimed in the specification annexed to the said letters patent, and that the same was not and were not known or used by any other person or persons before the invention and discovery thereof by your orator.

But now so it is, may it please your honors, that the said The Yale Lock Manufacturing Company, in violation of the rights of your orator, and intending to deprive him of the benefit of the said letters patent, and without license or permission, have, within the southern district of New York, made, used, and sold, and still continue to make, use, and sell, and to offer for sale, a large quantity of permutation locks, which infringe the said letters patent and the claim in the said letters patent contained, to the injury of your orator and his licensees, and have thereby unjustly and unlawfully made, and still make, great gains and profits which belong of right and according to law to your orator, and for which the said The Yale Lock Manufacturing Company wholly neglect and refuse to account to your orator. All which acts and doings are contrary to equity and good conscience, and tend to the manifest injury of your orator in the premises.

In consideration whereof, and forasmuch as your orator can only have adequate relief in this honorable court, where matters of this kind are cognizable by statute, to the end therefore that the said defendants, The Yale Lock Manufacturing Company, may, if they can, show why your orator should not have the relief hereby prayed, and may, according to their best and utmost knowledge, remembrance, information, and belief, full, true, direct, and perfect answer make to the matters and things hereinbefore stated and charged.

And that the defendants may be decreed to account with and pay over to your orator the profits which they have or might have made by such unlawful manufacture, use, and sale of locks containing the several combinations and things embraced in the said claim of the said letters patent.

May it please your honors, the premises considered, to grant unto your orator a writ of injunction issuing out of and under the seal of this honorable court, according to law, enjoining the defendants, their agents and servants, from further infringing the rights of your orator, and that your orator may have such other and further relief as the nature of his case may require and to your honors may seem meet.

And your orator further prays for a writ of subpœna to be directed to the defendants, commanding them to appear and answer this bill and to abide the orders and decrees of the court herein.

JAMES SARGENT.

JAMES H. FAY,
Solicitor for Complainant.
GEORGE T. CURTIS,
Of Counsel with the Complainant.

(Endorsed:) James Sargent *v.* The Yale Lock Man'f. Company. Bill in equity. Filed July 15, '72.

6 STATE OF NEW YORK, *County of Munroe:*

On this 10th day of July, 1872, personally appeared before me, James Sargent, who has subscribed this bill and made oath that he has read the same, and that the contents thereof are true as to the matters therein stated as of his own knowledge, and that as to all other matters therein stated he believes them to be true.

[L. S.] CHAUNCEY NASH,
Notary Public.

7 United States Circuit Court, Southern District of New York.
In Equity.

JAMES SARGENT
vs.
THE YALE LOCK MANUFACTURING COMPANY. } Suit No. 2.

The clerk of this court will please enter my appearance as solicitor for the defendants in the above-entitled cause.

Dated New York, August 31, 1872.

Yours, &c., &c., G. M. PLYMPTON,
Solicitor for Defendants, 245 Broadway.

(Endorsed:) United States circuit court, southern district of New York. James Sargent *vs.* The Yale Lock M'f'g Co. Notice of appearance. G. M. Plympton, sol'r for —. Filed Sep't 2, 1872.

8 U. S. Circuit Court, Southern District of New York. (In Equity.)

JAMES SARGENT
vs.
THE YALE LOCK MANUFACTURING COMPANY. } No. 2.

The answer of the above-named Yale Lock Manufacturing Company, defendants, to the bill of complaint of James Sargent:

The defendants, now and at all times hereafter saving and reserv-

ing to themselves all and all manner of benefit and advantage of exceptions which may be had or taken to the manifold errors, uncertainties, imperfections, and insufficiencies in the said bill of complaint contained, for answer thereto, or unto so much thereof as they are advised it is material or necessary for them to make answer unto, answering, say:

That they deny that letters patent were issued and granted to James Sargent, on the 4th day of January, 1870, for the term of fourteen years from and after the date thereof, as mentioned in said bill, nor do they know, nor are they informed, save by said
9 bill of complaint, whether or not the said James Sargent was a citizen of the United States, or whether or not application was made, as stated in said bill, or whether or not such proceedings were had on said application as therein stated, or what proceedings, if any, were had thereon, or whether or not the said alleged patent was duly issued and granted, as stated in said bill; nor do they know, nor are they informed, what said alleged patent purported to grant or secure to the said complainant, and leave the complainant to make such proof of the several matters above mentioned as he may be advised; but, on information and belief, these defendants deny that the said complainant was the first and original inventor of the alleged invention alleged to be patented by him in and by said alleged letters patent, dated the 4th day of January, 1870, and numbered 98622, and alleged to be issued to the complainant for an alleged improvement in permutation locks, or of any substantial or material part thereof; but, on the contrary, these defendants are informed and believe, and charge the fact to be, that the said improvement in permutation locks recited in said alleged letters patent was the invention of one Emory Stockwell, of Stamford, State of Connecticut, and that the said complainant was well aware of this fact, but, notwithstanding such knowledge, he, the said complainant, fraudulently obtained letters patent for that which he knew was invented by another, and that the said Emory Stockwell was, at the time said alleged patent was so obtained by the complainant, using reasonable diligence in adapting and perfecting said invention.

And these defendants, further answering, on information and belief, say that said alleged invention, and substantial and material parts thereof claimed as new, were, prior to any invention thereof by said complainant, known to and publicly used by divers persons in this country, and that among such persons were Emory Stockwell, Henry R. Towne, and Warren
10 H. Taylor, at Stamford, State of Connecticut, and all of whom now reside in said Stamford, State of Connecticut; John B. Yale, at said Stamford, State of Connecticut, and who now resides at Shelburne Falls, State of Massachusetts; Lyman F. Munger, at Rochester, State of New York, and who now resides at said Rochester, State of New York; and Linus Yale, Jr., late of Stamford, State of Connecticut, now deceased, to whom letters patent of the United States were granted on the 14th day of May, 1861, and numbered 32331, for an improved lock, which said letters patent were reissued

on the 28th day of May, 1863, and numbered 1469, and to whom letters patent of the United States were also granted on the 15th day of September, 1868, and numbered 82192, for an improved lock, which said improvements are the same, or substantially the same, as described in said alleged letters patent of the complainant. Each of said persons had such prior knowledge of said alleged invention, and publicly used the same in said cities of Stamford and Rochester, and each of whom now resides in said cities, with the exception of the said Linus Yale, Jr., who is now deceased.

And these defendants, further answering, deny, on information and belief, that at the time of the filing of said bill or at any other time the said complainant was in the rightful and exclusive possession or ownership of the said alleged invention mentioned in said bill or of any exclusive right under said alleged patent, and they deny, on information and belief, that the complainant now is or ever has been the sole and exclusive owner thereof, or that he is now entitled to the sole and exclusive use and benefit thereof.

And these defendants, further answering, say that they are making and selling, and for some time prior to the commencement of this suit did make and sell, improved permutation locks, under and by virtue of certain letters patent of the United States granted
11 to Linus Yale, Jr., on the 14th day of May, 1861, and numbered 32331, for an improved lock, which said letters patent were reissued on the 28th day of April, 1863, and numbered 1469; and also under letters patent of the United States granted to said Linus Yale, Jr., on the 15th day of September, 1868, and numbered 82192, for an improved lock, these defendants being the exclusive licensees under the same.

And these defendants, further answering, on information and belief, deny that in the southern district of New York or elsewhere at any time whatsoever these defendants deprived or intended to deprive the complainant of the benefit of said alleged letters patent or that they have unlawfully or wrongfully made, used or sold, or offered for sale, or that they are now unlawfully or wrongfully making, using or selling or offering for sale large or any quantities of permutation locks which infringe the said alleged letters patent, or the claim in the said alleged letters patent contained, to the injury of the said complainant and his licensees, or that they have unjustly and unlawfully made great or any gains and profits which he, the said complainant, alleges belong of right and according to to law to him.

And they deny, on information and belief, that the said complainant has sustained or suffered any loss or damage from any infringement of said alleged patent by these defendants, and these defendants pray the same benefits of the facts and things herein set forth as if for the reason thereof the said bill had been demurred to when a demurrer would have been proper, and the same benefit thereof as if they had been specially pleaded to such bill, and they submit to this honorable court that said complainant has no right to any further answer to said bill or any part thereof than is above given, and no right to any injunction, account, or other relief

prayed for in said bill, and these defendants pray to be hence
12 dismissed, with their reasonable costs and charges, in this behalf most wrongfully sustained.

HENRY R. TOWNE,
President of the Yale Lock M'f'g Co.

G. M. PLYMPTON,
Solicitor and of Counsel for Def'ts.

UNITED STATES OF AMERICA,
Southern District of New York, City and County of New York, } *ss:*

On this sixth day of November, 1872, before me personally appeared Henry R. Towne, president of the defendants in the above-entitled suit, who, being duly sworn, says that he has read the foregoing answer subscribed by him, and knows the contents thereof; and that the same is true of his own knowledge, except as to
13 those matters which are therein stated upon information and belief, and as to those matters he believes it to be true.

NOAH TUGWELL,
Notary Public, N. Y. Co.

(Endorsed:) United States circuit court, southern dist. of New York. James Sargent *vs.* The Yale Lock Manufacturing Company. Answer. G. M. Plympton, sol. and of counsel for def'ts, 245 Broadway. Filed Nov. 6, 1872.

14 *The Reply of the above-named James Sargent to the Answer of the Yale Lock Manufacturing Company.*

United States Circuit Court, Southern District of New York. In Equity.

JAMES SARGENT *ag'st* THE YALE LOCK MANUFACTURING COMPANY.

This repliant, saving and reserving to himself all and all manner of advantage of exception to the manifold insufficiencies of the said answer, for the replication thereunto says that he will aver and prove his said bill to be true, certain, and sufficient in the law to be answered unto, and that the said answer of the said defendants is uncertain, untrue, and insufficient to be replied unto by this
15 repliant, without this, that any other matter or thing whatsoever in the said answer contained material or effectual in the law to be replied unto, confessed and avoided, traversed or denied, is true; all which matters and things this repliant is and will be ready to aver and prove as this honorable court shall direct, and hereby prays as in and by the said bill he has already prayed.

JAMES H. FAY,
Solicitor for Complainant.

GEO. T. CURTIS,
Of Counsel.

(Endorsed:) U. S. circuit court. James Sargent *vs.* The Yale Lock Manufacturing Company. James H. Fay, compl'ts' sol'r, 9 Nassau St. Filed Dec'r 21, '72.

16 *Proofs for Final Hearing in the above-entitled Cause, taken before Edward G. Thompson, one of the Standing Examiners of this Court, on the part of the Complainant, under and pursuant to the 67th Rule in Equity, as amended.*

United States Circuit Court, Southern District of New York. In Equity.

JAMES SARGENT
vs.
THE YALE LOCK MANUFACTURING CO. } Suit No. 2.

NEW YORK, *May* 5, 1873—11 a. m.

Present: E. Wetmore, Esq., counsel for complainant; G. M. Plympton, Esq., counsel for defendant.

SPENCER H. COLE, a witness produced on behalf of the complainant, being first duly sworn, in answer to interrogatories propounded by Mr. WETMORE, deposes and says:

1 Q. What is your name, age, residence, and occupation?

A. Spencer H. Cole; I am 29 years of age; I reside at No. 402 Sacket street, Brooklyn; safes, locks, adjustable elbows, &c.

17 2 Q. Are you acquainted with the various combination locks to be found on sale in the market in this city; and, if yea, how long have you been so acquainted?

A. I am, and have been for about six years.

3 Q. Do you know the Yale Lock Manufacturing Co., the defendants in these suits; and, if so, how long have you known them, and what is their business, and where do they carry it on?

A. I have known them in a business way during nearly all this time; that is, the last six years. They are manufacturers of bank and other locks. Their manufactory is at Stamford, Conn., and they have a sales-room in this city.

4 Q. Can you produce specimens of any of the combination locks so manufactured and offered for sale by said Yale Lock Manufacturing Co.; and, if yea, will you please produce said specimens, and state how long you have known of the same being offered for sale or sold in the market by said company?

A. I can; and I produce two locks.

(Locks offered in evidence, and marked Complainant's Exhibits "Cole No. 1" and "Cole No. 2," E. G. T., Ex'r.)

I have known Exhibit Cole No. 1 for several years. Exhibit Cole No. 2 I have not known for so long a time—probably for a year and a half.

Subscribed and sworn to before me, this 5th day of May, 1873.
E. G. THOMPSON, *Examiner.*

HENRY B. RENWICK, a witness on the part of the complainant, being produced and duly sworn, in answer to interrogatories propounded by Mr. WETMORE, deposes and says:

1 Q. What is your name, age, residence, and occupation?

A. Henry B. Renwick; I am 55 years of age; I reside
18 in the city of New York; my principal occupation at present is the examination of machinery and patents, and I am frequently called as an expert in the circuit court of the United States in various circuits in suits in such courts on patents.

2 Q. Please state what experience you have had in regard to the study of mechanics, and the application thereof, especially in regard to combination locks.

A. I have been studying mechanics ever since I entered college. I have paid especial attention to locks for about twenty-five years, commencing when I was examiner in the Patent Office, where I had the matter of locks in charge. Since then I have drawn many specifications for patents for locks, and have been examined as expert in suits under lock patents.

(Plaintiff's counsel offers in evidence copy of the letters patent to James Sargent for improvement in permutation locks, No. 98622, dated January 4, 1870, marked Complainant's Exhibit No. 1, suit No. 2.)

3 Q. Have you read and do you understand the specification of Sargent's patent for a double roller, No. 98622, and being Complainant's Exhibit No. 1, suit No. 2?

A. I have frequently read an official copy of the patent, and believe that I understand the invention described therein.

4 Q. Please examine the lock marked Exhibit Cole No. 1, and compare the same with the device and improvement mentioned in the specification and claim of the said patent; and if you say that you find the same device or improvement in the said lock, please give your reasons therefor.

A. I have examined the lock Cole No. 1. It has two disconcerting rollers in combination with a cam upon which they ride. These rollers being for the purpose of preventing a lock-picker from ascertaining the position of the rotary tumblers by means of a micrometer, and in this respect it is substantially identical with the contrivance described in the patent. Whether these rollers in
19 the exhibit are of varying eccentricity or not I cannot positively determine, although they appear to be so by examination of them without instruments. A variation of eccentricity between the two rollers, which could be measured by a micrometer only, would be sufficient to secure the object which these rollers are designed to effect, and they may have such eccentricity, and yet it may be impossible to determine it by the eye alone.

Examination adjourned to May 7, 1873, at 11 a. m.

NEW YORK, *May* 7, 1873—11 o'clock a. m.

Present: Counsel for both parties.
Met pursuant to adjournment.

Mr. RENWICK, being cross-examined by Mr. PLYMPTON, deposes and says:

5 X Q. In your answer to the 4th direct question you state that the rollers referred to in said question are identical with the contrivance described in the patent, but whether these rollers in the exhibit (marked Cole No. 1) are of varying eccentricity or not you cannot positively determine. Please look at said rollers carefully and state if upon this second examination of them you can now determine whether or not they are of varying eccentricity.

A. I cannot tell with certainty whether they are or are not of varying eccentricity.

HENRY B. RENWICK.

Sworn and subscribed to before me, this 7th day of May, 1873.

E. G. THOMPSON,
Examiner.

20 NEW YORK, *Feb.* 7, 1874.

Cross-examination of HENRY B. RENWICK, a witness on the part of the complainant, continued:

6 X Q. Please look at the patent issued to James Sargent on the 4th day of January, 1870, No. 98622, and state what you understand the words "varying eccentricity" to mean as applied to the rollers described in said letters patent.

A. I have examined the patent, and believe that the words "varying eccentricity," as applied to the rollers, mean that the rollers shall have their axes at different points in their diameters. If the two rollers be each $\frac{3}{4}$ of an inch in diameter, and one have its axis $\frac{3}{1000}\frac{5}{0}$ of an inch from the nearest point in its periphery and the other have its axis $\frac{4}{1000}\frac{0}{0}$ of an inch from the nearest point of its periphery, then they will be of varying eccentricity. This variation of distance of the axis from the nearest point of the periphery need be no greater than the smallest distance that can be measured by the sensitive micrometers used in lock-picking, for the reason that the whole aim of the patented contrivance is to avoid picking by means of a micrometer.

HENRY B. RENWICK.

Counsel for the defendant gives notice to counsel for the complainant that at the final hearing of this suit he will move that the bill be dismissed with costs for failure to prove infringement.

It is admitted that the witness, Spencer H. Cole, is the agent in the city of New York for the sale of the complainant's locks.

Complainant closes.

E. G. THOMPSON, *Examiner.*

21 COMPLAINANT'S EXHIBIT No. 1. E. G. T., *Ex'r.*

SARGENT
vs.
YALE LOCK MAN. CO. } Suit No. 2. May 5, 1873.

United States Patent Office.

JAMES SARGENT, of Rochester, New York.

Letters Patent No. 98622, dated January 4, 1870.

Improvement in Permutation Locks.

The schedule referred to in these letters patent and making part of the same.

To all whom it may concern:

Be it known that I, James Sargent, of the city of Rochester, in the county of Monroe and State of New York, have invented a certain new and useful improvement in locks, and I do hereby declare that the following is a full and exact description of the same, reference being had to the accompanying drawings, in which—

Figure 1 is an elevation of the lock, with the back plate removed to show the interior.

Figure 2, a vertical cross-section of the same.

Figure 3, a diagram, showing the cam and the disconcerting eccentries in perspective.

Like letters of reference indicate corresponding parts in all the figures.

Nature of the Invention.

This lock is an improvement upon that of Linus Yale, in which an eccentric roller is combined with the cam for disconcerting the action upon the tumblers.

The invention consists in combining with the cam an arrangement of two or more eccentric rollers, of varying eccentricity, turning upon the same bearing, so that in revolving one or both may turn and alternate in action, thereby greatly increasing the difficulty of mapping out or locating the position of either.

22 *General Description.*

In the drawings—

A represents the case of the lock;

B, the cylinder for holding the tumblers or wheels;

C, the spindle;

D, the cam;

E, the dog which falls to release the bolt; and

G, the bolt.

These are the ordinary parts employed in combination locks, and may be arranged in any desired manner; hence, they need no special description here.

A single eccentric roller, H, pivoted, at *a*, to a suitable arm or bearing, and resting upon the cam D, has been before employed, as already stated.

Its object is to disconcert the action inside the lock, so that an expert lock-pick or burglar cannot tell the position of the tumblers when operating upon the lock.

It has been found by experiment, however, that such a device is not proof against the skill of an expert lock-pick, for, by the use of a delicate instrument attached to the spindle outside, and by careful manipulation, the shape and position of this roller can be actually mapped out or ascertained and the lock opened.

To obviate this difficulty as far as possible, I combine with this roller one or more rollers H′, pivoted to the same arm or bearing, and resting upon the periphery of the cam in the same manner; but all these rollers are made of varying eccentricity, and of different shape, and, therefore, when the cam is turned, the several rollers strike at different positions, and when one touches the other may be removed from contact, thus alternating in action. They may also turn in different directions.

By this means, owing to the different contact of the several rollers, the difficulty of mapping out and locating the same is very greatly increased.

In transferring the action from one roller to the next, the loss of contact with the first disarranges the position, and thus renders it indefinite.

In this manner, and for this reason, the addition of another roller to the one already in use does not produce an accumula-
23 tion of the same effect in action, but produces a different action altogether, by breaking the continuity of rotation and movement and contact.

I disclaim the employment of a single eccentric; but what I claim as my invention, and desire to secure by letters patent, is—

The arrangement of two or more rollers, H, H′, of varying eccentricity, when combined with the cam, in the manner and for the purpose specified.

In witness whereof I have hereunto signed my name, in the presence of two subscribing witnesses.

JAMES SARGENT.

Witnesses:
R. F. OSGOOD.
GEO. W. MIATT.

24 *Proofs for Final Hearing taken on the above Cause under and pursuant to the 67th Rule in Equity, before Joseph Gutman, Jr., Examiner.*

Circuit Court of the United States for the Southern District of New York. In Equity.

JAMES SARGENT
vs.
THE YALE LOCK MANUFACTURING COMPANY. } No. 2.

N. Y., *February* 20, 1874—10 a. m.

Met pursuant to notice.

Present: G. M. Plympton, Esq., counsel for defendant, and Edmund Wetmore, Esq., counsel for complainant.

A. I believe that to be the only essential difference in the construction of the two rollers you refer to.

10 X Q. I understand, in your answer to the 4th direct interrogatory, in which you state you directed your rollers to be made in the form which your experiments had proved to be the best, that you mean that your experiments proved that the device of
28 eccentric disconcerting rollers which you state you adopted were superior to the other disconcerting devices which you tried, without regard to whether the latter were rollers or not; is that correct?

A. Not entirely. We experimented with other devices which were perhaps equally effective, but this being the simplest and most easily applicable to locks already made were adopted. We have since abandoned it for a better device.

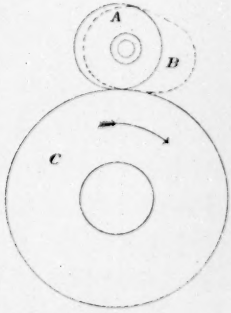
And being further examined by Mr. PLYMPTON, he says:

11 re-D. Q. In your answer to your cross-question 9 you state that you believe the only essential difference existing between the complainant's rollers and the defendant's rollers are that in the defendant's rollers they will coincide throughout their entire peripheries, while in the complainant's rollers they cannot coincide throughout their entire peripheries. This being a difference in construction, state, if you please, what difference, if any, exists in the operation of the complainant's and defendant's rollers, and in the results, if any such exist?

A. The disconcerting rollers, as originally used, consisted of a single eccentric disc resting on the periphery of a cam, the object of its eccentricity being to introduce an element of uncertainty between the fence, or dog, and the operating spindle of the lock, so that in an attempt to pick the lock by means of a micrometer, this eccentricity being variable and uncertain, would disconcert any one attempting to measure the point of contact of the fence with the tumblers. It was eventually discovered, however, that with a single eccentric roller the desired uncertainty was not obtained; that by carefully rotating the cam, two points, one on the cam and the other on the roller, which at a given time might be in juxtaposition, could be readily returned to the same position, providing only that a correct record was kept of the revolutions or parts of revolutions through which the cam
29 might be moved, and that these motions of the cam were repeated in a reverse direction. In other words the cam and roller operated together substantially as would two spur gears of similar diameters. It will be seen, therefore, that the relative positions of the cam and roller were positive, instead of variable, and the desired uncertainty in their relative positions not obtained. Locks constructed upon this principle have been picked, thereby demonstrating the uselessness of the device and the fallacy of the principle upon which it was constructed. The double disconcerting roller made and used by us overcame this difficulty. The action of a pair of eccentric rollers, each of which is identical with the other in shape and eccentricity, revolving upon the periphery of a cam, was found,

by experiment, to be in the highest degree variable and uncertain. As the cam was revolved, sometimes one roller would turn (the other remaining stationary) and sometimes the other, while at other times, the two rollers having been rotated to a point at which their peripheries exactly coincided, both would revolve together for a short period, until some slight impediment or change in the periphery of the cam would cause one to bear more directly than the other upon the periphery of the cam, when this one would revolve with the cam, the other remaining stationary, and so on. In this way a perfect disconcerter was obtained, which would effectually baffle any attempts to measure the point of contact of the fence with the tumblers. The action of a pair of rollers constructed in the manner described in complainant's patent would not necessarily be such as to produce the desired uncertainty, and I can best illustrate the reason of this by means of the accompanying diagram, in which "C"

30



represents the cam of a lock, and "A" and "B" two rollers of varying eccentricity resting thereon. A pressure upon the spindle, on which the rollers rotate, will obviously be resisted only by the roller "A" and the cam "C" being rotated in the direction of the arrow, the excess of the eccentricity of the roller "B" over that of the roller "A" will cause the former to remain in the position shown by the dotted lines, and will prevent its further rotation into a position in which it would relieve the roller "A" of its bearing and itself take the pressure. It will be seen, therefore, that this would entirely fail to accomplish the desired object, and would in in reality have the same action and be open to the same objections as the single eccentric roller which I first described and which was proved to be worthless. In the diagram, I have purposely exaggerated the variation in the eccentricity of the two rollers, in order to make more apparent the point I desired to explain, but it is evident that the same action will result with rollers of a greater or less degree of variation in their eccentricity.

The essential difference between the double roller made by us, and that explained in complainant's patent is, that in our device the two rollers will, from time to time, come into such a position that their

two peripheries will exactly coincide; that they will, each of
31 them, bear a part of the strain, and that they will revolve together for a short interval, until some trifling variation in the periphery of the cam disturbs the equality of the bearing, transfers the strain to one of them, which will continue to revolve and leave the other temporarily stationary, whereas the action of a pair of rollers, constructed as described in complainant's patent, will, in all probability, be such as I have above described, and will, for the reasons I have given, fail to accomplish the desired end.

HENRY R. TOWNE.

Sworn to before me, this 20th day of February, 1874.

JOSEPH GUTMAN, JR.,
Examiner.

Mr. EMORY STOCKWELL, a witness of lawful age, produced on the part of the defendant, and being by me first duly cautioned and sworn to testify the truth, the whole truth, and nothing but the truth, in the matter of controversy herein, and being examined by Mr. PLYMPTON, deposes and says as follows:

1 Q. What is your name, age, residence, and occupation?

A. My name is Emory Stockwell; age, 40 years; residence, Stamford, Connecticut; and occupation, manufacturer of locks with the Yale Lock Manufacturing Company of Stamford, Connecticut.

2 Q. What are your special duties with the Yale Lock Manufacturing Company?

A. To superintend the manufacture of bank and safe locks.

3 Q. Are the disconcerting rollers used in said locks made under your supervision?

A. They were, as long as they were made by the Yale Lock Manufacturing Company.

4 Q. How were these rollers made, or how did you direct them to be made?

32 A. That is the general way of manufacturing them. They were first cast into two separate pieces, and then drilled and turned up on a mandrel separately, except the periphery; then they were placed together, as you find them in the lock, attached to a chuck, with the centre hole a little eccentric with the axis of the spindle of the lathe; then, with a slide rest, a tool cuts off the periphery to the desired size, both being made precisely the same.

5 Q. From the manner you have described of making these disconcerting rollers, is it possible to make these rollers of varying eccentricity and of different shape?

A. It is not.

6 Q. Please look at the device marked "Defendant's Exhibit A," and state what it is fully and particularly.

A. That is a chuck fitted to a lathe spindle, made expressly for the making of that roller, of the same character as described above, and has attached to it a pair of rollers turned and finished in the manner described; this identical chuck, "Exhibit A," being the only chuck ever used by us in making the double roller, and they were

never made in any other way by the Yale Lock Manufacturing Company, aside from experimenting.

E. STOCKWELL.

Sworn to before me, this 24th day of Feb., 1874.

JOSEPH GUTMAN, JR.,
Examiner, &c.

Adjourned until — day of February, 1874.

33 NEW YORK, *September* 10, 1874—11 a. m.

Parties met, pursuant to adjournment.

Present: Mr. Plympton, counsel for defendants.

EDWARD S. RENWICK, a witness of lawful age, produced on the part of the defendant, having been by me first duly cautioned and sworn to testify the truth, the whole truth, and nothing but the truth, in the matter of controversy herein, and being examined by Mr. PLYMPTON, deposes and says as follows:

Q. 1. What is your name, age, residence, and profession?

A. My name is Edward S. Renwick; I am 51 years old; I reside at Milburn, N. J., my place of business being the city of New York; I am by profession a mechanical and civil engineer, but am occupied almost exclusively in acting as expert in the trials of patent causes and in soliciting patents.

Q. 2. Please state what experience, if any, you have had in mechanics, especially respecting the construction of combination locks.

A. I was engaged for a number of years almost exclusively in the construction of machinery and in the superintendence of machinery in motion; for more than 25 years I have been engaged in my present occupation, and during that period I have had to make numerous investigations in the history of the useful arts as set forth in books, in patents, and in the recorded descriptions of American and foreign patents, for the purpose of ascertaining whether patented inventions of many descriptions were novel or otherwise; I have also examined a great number of machines for performing many different operations in the useful arts; I have also operated many machines of different descriptions and have adjusted them for use;

34 I have been called upon to testify in a great number of patent causes, being called upon many times every year for that purpose; I have been called upon to testify as expert in various cases in which the construction and operation of locks and lock mechanism was the subject-matter of the controversy; I have examined a large number of locks of various descriptions and a great number of patents relating to the construction of locks and lock mechanism; I have also had to prepare specifications for patents for locks and lock mechanism.

Q. 3. Have you read and do you understand letters patent No. 98622, dated January 4, 1870, granted to James Sargent, of Rochester, and marked Defendant's Exhibit B?

A. I have read a Patent Office copy of the letters patent referred to in the question, and believe that I understand the contents thereof and the construction and operation of the mechanism described and recited therein.

Q. If you were called upon as an expert to have constructed from the letters patent No. 98622, dated January 4, 1870, the eccentric rollers described and shown in said patent, what would be the construction of such rollers, as you understand the description therein given?

A. Each roller would have the form of a disc, perforated in the vicinity of its centre for the passage of the pivot on which it was to revolve, and the centre of the perforation of each roller would be at a distance from the centre of the periphery of the roller different from that of the centre of the perforation from the periphery in every other roller which was arranged to turn upon the same pivot. Moreover, the shape of each roller would be different from that of every other roller arranged to turn upon the same pivot; thus, if there were to be two rollers arranged to turn upon the same pivot, and the centre of the pivot hole or perforation of one of them should be made $\frac{1}{50}$th of an inch at one side of the centre of the periphery of that roller, then the centre of the pivot hole or perforation of the second roller would necessarily have to be made more or less than $\frac{1}{50}$th of an inch at one side of the centre of its periphery, as, for example, $\frac{2}{50}$ths of an inch at one side of that centre. Moreover, as the rollers are to be made of different shapes, if one of them should be made with a truly circular periphery, the other one would have to be made with a periphery either bulged or depressed at some portion or portions of its circumference, so that it might be of a different shape from a true circle; the rollers thus made would correspond precisely with the following description, which I find in the patent: "But all these rollers are made of varying eccentricity and of different shapes." * * * "In this manner and for this reason the addition of another roller to the one already in use does not produce an accumulation of the same effect in action, but produces a different action altogether, by breaking the continuity of rotation and movement, and contact."

Q. 5. Please look at defendant's Exhibit A and state whether or not it would be possible on the chuck there shown, and the screw securing the rollers to the chuck as the rollers on said chuck are secured, to make the rollers of varying eccentricity, both being turned simultaneously on the lathe.

A. Upon examining Exhibit A, I find that it is an implement commonly known as a chuck, to be used in connection with a turning lathe, into the head of the mandrel of which, the screwed stem of the chuck is screwed, so that the chuck and the rollers screwed to it may be caused to revolve simultaneously for the purpose of turning them. I also find that the stem of the iron clamp screw is eccentric to the body of the chuck, and that the pivot holes in both rollers fit snugly upon the stem of the clamp screw when the latter is screwed up, so that the centres of the pivot holes of both rollers must correspond with the axis of the clamp screw. With

36 both rollers screwed in this manner, and both turned simultaneously, it will be practically impossible to make the rollers with varying eccentricity. I say, practically impossible, because I assume that the tool by which the rollers are turned is operated in the usual manner with an ordinary slide rest, which holds the tool firmly, as appears to have been the case in turning the two rollers now secured to Exhibit A, for, if the tool had not been so held, its movement would produce inequalities in the rims of the rollers, which would be apparent on inspection, and no such inequalities appear in the two rollers now secured to the exhibit.

Q. 6. Will you examine the rollers secured to complainant's Ex-Cole No. 1, and state if you find said rollers to be of varying eccentricity, and if you do so find them, give your opinion as to how that varying eccentricity was produced.

A. As far as I can determine by the eye, the eccentricity of the two rollers referred to in the question appears to be the same, but the forms of the rims of the rollers have apparently been changed by hammering them since they were turned, so that the two rollers are not of precisely the same shape. The hammering appears to have been done by holding the two rollers together upon a hard surface with the side of the roller which is nearest the back of the lock case upon the said surface, and by hammering upon the side of the other roller, which, when in the lock, is nearest to the front of the lock case. They also appear to have been hammered on their rims.

E. S. RENWICK.

Subscribed and sworn to before me, this 10th day of September, 1874.

JOSEPH GUTMAN, JR.,
Examiner, &c.

Adjourned subject to new order.

37 N. Y., *October* 15, 1874—3.30 p. m.

Present: Counsel for the respective parties.

The witness, EDWARD S. RENWICK, being cross-examined by Mr. WETMORE, says:

X Q. 7. What would be the difference, in your opinion, in practical effect as a security against picking between a pair of disconcerting rollers, both eccentric, but both having the same degree of eccentricity of the same form and size, as compared with a pair of disconcerting rollers in which the eccentricity of one roller should differ from the eccentricity of the other as you understand to be directed by the patent?

A. Practically I do not know as I have ever known a lock with either of the kinds of rollers mentioned in the question to be picked, but I am of opinion that that lock which had the two rollers of different eccentricities would be the most difficult to pick, because it is within the limits of possibility that two rollers of the same eccentricity, size, and form might move so as to correspond exactly, in

which case they would operate as a single roller, whereas with the other form of the lock this result would be absolutely impossible.

X Q. 8. Would not the pair of rollers in each of the cases supposed operate in substantially the same way and produce substantially the same effect as a security against picking at all times, except when, as you have last supposed, it should happen or be contrived that the two rollers should coincide so as to act as one?

A. The pair of rollers, if started purposely in different positions when the lock was first put in use, would operate substantially the same as two rollers having different eccentricities until the pair should become coincident, when they would cease to operate as the other two.

38 X Q. 9. Does not ordinary use in a lock indent the sharp edges of the rollers to some extent so that it would be difficult to tell by the eye whether or not they were of exactly the same eccentricity when at rest, and are not the disconcerting rollers in the lock Exhibit A, in suit No. 1, somewhat indented so that it would be difficult to pronounce an opinion upon that point.

A. So far as I know I cannot say whether the rollers are or are not indented by ordinary use in the lock; in the case of the rollers of Exhibit A there are various scratches upon them which must have been produced by some other means than the ordinary use of the lock; moreover, their rims are not absolutely two circles, but they are, so far as I can see, of the same eccentricity.

E. S. RENWICK.

Subscribed and sworn to before me—

JOSEPH GUTMAN, JR.,
Examiner.

39 U. S. Circuit Court, Southern District of New York. In Equity.

JAMES SARGENT
vs.
THE YALE LOCK MANUFACTURING CO. } Case No. 2.

Proofs for Final Hearing in Rebuttal on Part of the Complainant.

Interrogatories to be administered to James Sargent, a witness in behalf of the complainant.

1. What is your name, age, residence, and occupation?
2. How long have you been engaged in the manufacture of bank locks?
3. Are you practically familiar with the details of such manufacture, and with the manufacture of the wheels and separate pieces of such locks?
4. Are you the complainant in this suit and the patentee mentioned in the patent in suit No. 98622?
5. Please state generally what is a micrometer and how it operates as a means of picking locks?
6. Are you familiar with the lock known as the Yale dial lock, of which Exhibit Cole No. 1, in this suit, and the lock Defendant's

Exhibit A, in the suit known as Sargent *vs.* The Yale Lock Manufacturing Co. No. 1, are specimens, and have you examined said exhibits?

7. Do you know whether the said Yale dial lock, when
40 constructed with a single disconcerting roller, was ever picked by means of the micrometer; and, if so, by whom, if you know, was it first picked by such means?

8. How long was the dial lock, Exhibit Cole No. 1, in your possession or that of your firm before it was put in evidence in this suit, and was anything, to your knowledge, ever done to the disconcerting rollers in said lock, as respects hammering them or in any way altering their shape?

9. Have you read the testimony of Mr. Towne and Mr. Stockwell, for the defendant, as to the manner in which the disconcerting rollers used in the locks like Exhibit Cole No. 1 were turned and made?

10. Would it or not be possible, in your judgment as a mechanic, to make such rollers in the manner described by the defendant's witnesses so that they would be exactly of the same eccentricity and shape, without a difference between them sufficient to be measured by the micrometer?

11. In operation and effect, as a security against picking, what difference, if any, exists between a pair of disconcerting rollers like those shown in Exhibit Cole No. 1, assuming said rollers to have been originally made in the manner testified to by the defendant's witnesses, and a pair of disconcerting rollers, made of varying eccentricity, as described in the patent in suit No. 98622?

Cross-interrogatories to be administered to James Sargent, a witness on behalf of the complainant.

1 X Q. From whom was the dial lock, Exhibit Cole No. 1, obtained; when was it so obtained, and in whose possession has it been since it was first obtained?

2 X Q. Did the dial lock, Exhibit Cole No. 1, when first obtained, have fitted to it two disconcerting rollers; if yes, how do you know this fact, and did you see such rollers?

41 3 X Q. Did you, or did any one under your direction or suggestion, fit the dial lock, Exhibit Cole No. 1, with one or more disconcerting rollers?

4 X Q. If you answer the last cross-interrogatory in the affirmative, are the disconcerting rollers now affixed to said lock the identical rollers that you affixed or caused to be affixed thereto?

5 X Q. If you answer cross-question 3 in the negative, are the rollers attached to said dial lock, Exhibit Cole No. 1, the identical rollers that were secured to said lock at the time it was first obtained by you, your firm, your predecessors, or your successors, or by any of your or their servants, agents, clerks, or attorneys for the same, or either of them?

6 X Q. If said dial lock, Exhibit Cole No. 1, was provided with two disconcerting rollers at the time said lock was first procured, did said rollers exhibit, as they now exhibit, marks of violence, battering, and mutilation on their peripheries?

7 X Q. If you answer the last cross-interrogatory, either affirma-

tively or negatively, state why you remember the same, and why your attention was first called to the fact?

8 X Q. If you answer the 10th direct interrogatory, in substance, that it would not, state if you have tried to make such rollers in the manner inquired of, so that they would be exactly the same; and, if you say you have, did you test them with a micrometer; if yes, when and where, and under what circumstances, and with what results?

9 X Q. If you state that you did test said rollers by a micrometer, were the rollers so tested two disconcerting rollers affixed to the fence lever of a lock, and were said rollers manufactured by the defendant, or were they not?

10 X Q. If you answer that they were not constructed by the defendant, by whom were they made, and when and where and under what circumstances?

11 X Q. If you answer that they were constructed by the defendant, were they like the disconcerting rollers attached to the dial lock, Exhibit Cole No. 1?

12 X Q. Did you ever test by micrometer the disconcerting
42 rollers attached to lock, Exhibit Cole No. 1; if yes, when and where, and under what circumstances, and with what result?

Addition to X interrogatories to James Sargent on commission.

13 X Q. Are you a practical mechanic; if yes, when, where, and under what circumstances did you become such? In what shop or place did you serve your time, and in what particular branch of mechanics have you worked as a mechanician?

Deposition of James Sargent, a witness produced, sworn, and examined on the 17th day of November, 1874, at the city of Rochester, N. Y., under and by virtue of a commission issued out of the United States circuit court for the southern district of New York (by stipulation), in a certain cause therein depending and at issue between James Sargent, plaintiff, and The Yale Lock Manufacturing Company, defendant, as follows:

JAMES SARGENT, of the city of Rochester, N. Y., manufacturer of locks, &c., aged 49 years and upwards, being duly sworn and examined on the part of the plaintiff, doth depose and say as follows:

First. In answer to the 1st interrogatory the witness saith: My name is James Sargent, my age 49, my residence Rochester, N. Y., and my occupation a manufacturer of locks of various styles, making a specialty of burglar-proof bank locks.

Second. In answer to the 2d interrogatory the witness saith: I have been engaged in the manufacture of bank locks for the most part since the spring and summer of 1861.

Third. In answer to the 3d interrogatory the witness saith: I am.

Fourth. In answer to the 4th interrogatory the witness saith: I am.

Fifth. In answer to the 5th interrogatory the witness saith: The

micrometer used by me is an instrument invented by me capable of measuring a difference of the two-thousandth part of an inch in the diameter of two wheels or the length of two tumblers, and it is applied by me and others to the use of picking locks; in a
43 combination lock it operates to indicate the high and low places in the wheels, by which I am able to locate the slots and open the lock.

Sixth. In answer to the 6th interrogatory the witness saith: I am familiar with the lock known as the Yale dial lock, of which Exhibit Cole No. 1 in this suit and the lock Defendant's Exhibit A in the suit known as Sargent *vs.* The Yale Lock Manufacturing Co., No. 1, are specimens, and I have examined said exhibits.

Seventh. In answer to the 7th interrogatory the witness saith: I do know that the said Yale dial lock, with a single disconcerting roller, was picked by the use mainly of the micrometer first by Lyman F. Munger and myself.

Eighth. In answer to the 8th interrogatory the witness saith: I do not remember how long the dial lock Exhibit Cole No. 1 was in my possession or that of my firm before it was put in evidence in this suit, but it was a very short time. Nothing was ever done to the disconcerting rollers in said lock, as respects hammering them or in any way altering their shape, to my knowledge.

Ninth. In answer to the 9th interrogatory the witness saith: I have.

Tenth. In answer to the 10th interrogatory the witness saith: In my judgment it would not be possible.

Eleventh. In answer to the 11th interrogatory the witness saith: There would be no difference whatever.

Answers to Cross-interrogatories.

1. In answer to the 1st cross-interrogatory the witness saith: The dial lock, Exhibit No. 1, was obtained from the Yale Lock Manufacturing Company a short time before it was put in evidence in this case. It has been in the hands of my attorneys in this suit ever since it was put in evidence.

2. In answer to the 2d cross-interrogatory the witness saith: Yes; I saw the lock and examined the rollers.

3. In answer to the 3d cross-interrogatory the witness saith: No.

4. In answer to the 4th cross-interrogatory the witness saith nothing.

44 5. In answer to the 5th cross-interrogatory the witness saith: To the best of my knowledge they are, and I believe they are the identical rollers.

6. In answer to the 6th cross-interrogatory the witness saith: They did not, to my knowledge.

7. In answer to the 7th cross-interrogatory the witness saith: I remember examining the bolts and the rollers carefully at the time the bolt was put in evidence in this suit. If there had been any marks of violence, battering or mutilation, on the peripheries it would have attracted my attention, and I would have remembered

it. My attention was first called to the fact (if a fact) by the printed testimony of defendant in this suit. Whether said rollers now have any marks of violence, battering or mutilation, I know not. I don't know that they ever had such marks, or any marks other than proper usage would necessarily produce.

8. In answer to the 8th cross-interrogatory the witness saith: I have many times tried to make rollers in the manner enquired of so that they would be exactly the same, and I have tested them with a micrometer. I have tested with a micrometer two disconcerting rollers made in the manner enquired of at my factory in Rochester, N. Y., in 1870, and by this means found them unlike.

9. In answer to the 9th cross-interrogatory the witness saith: The rollers tested were two disconcerting rollers; some of them were affixed to the fence lever of a lock and some of them were not; some of them were manufactured by defendant and some were not.

10. In answer to the 10th cross-interrogatory the witness saith: Those not constructed by defendant were made by D. O. Page, by myself, and by mechanics in my employ from time to time during the past ten years, when in Cincinnati and Rochester, when experimenting with different styles of locks with a view to picking them.

11. In answer to the 11th cross-interrogatory the witness saith: So far as I know, those constructed by the defendant were.

12. In answer to the 12th cross-interrogatory the witness saith: I never did.

45 13. In answer to the 13th cross-interrogatory the witness saith: I am; from 1838 to 1848 I worked in woolen factories in Ludlow, Cavendish, and Springfield, Vermont, and Ashuelot, N. H.; a good portion of the time I superintended the work of the carding, spinning, and weaving, and at the same time kept the machinery in repair; from 1852 to 1857 I was engaged in manufacturing apple-parers and bits and gimlets, at Shelburne Falls, Mass.; from 1861 to the present time I have been engaged in the manufacture of locks, making a specialty of bank and safe locks, at Shelburne Falls, Mass., and Rochester, N. Y.; and within the last ten years have taken out eight or ten patents for improvements in locks, safes, machinery, &c., invented by myself; in all this business I have been personally and practically engaged as a mechanician.

JAMES SARGENT.

NORTHERN DISTRICT OF N. Y., }
Monroe County, } *ss:*

Examination taken, reduced to writing, and by the witness subscribed and sworn to, this 17th day of November, 1874, before—

MARTIN W. COOKE,
Notary Public and Commissioner.

Decree.

Circuit Court of the United States of America for the Second Circuit and Southern District of New York. April Term, A. D. one thousand eight hundred and seventy-five.

JAMES SARGENT, Complainant,
vs.
THE YALE LOCK MANUFACTURING COMPANY, Defendant. } Suit No. 2.

This cause having been brought to a final hearing upon the pleadings and proofs, and George T. Curtis and Edmund Wetmore having been heard on the part of the complainant, and Gilbert M. Plympton on behalf of the defendant, and thereupon, upon consideration, it was and is ordered, adjudged, and decreed that letters patent
47 numbered 98622, and dated January 4th, 1870, granted to James Sargent, the complainant herein, and being the letters patent referred to in the complainant's bill, is a good and valid patent, and that the said James Sargent was the original and first inventor of the improvements described and claimed in said patent, and is the exclusive owner thereof, and that the defendant, The Yale Lock Manufacturing Company, has infringed upon the said patent and upon the exclusive rights of the complainant under the same.

And it was and is further ordered, adjudged, and decreed that the complainant recover of the defendant, The Yale Lock Manufacturing Company, the gains, profits, and advantages which the said defendant, The Yale Lock Manufacturing Company,
48 has received or made, or which have arisen or accrued to it from said infringement of said patent by the manufacture, use, or sale of the improvements described and secured by said letters patent number 98622, and the damages sustained by the complainant over and above the said profits, gains, and advantages.

And it was and is further ordered, adjudged, and decreed that the said complainant recover of the said Yale Lock Manufacturing Company the costs and disbursements in this suit to be taxed.

And it is further ordered, adjudged, and decreed that it be referred to Edward G. Thompson, Esquire, who is hereby appointed master *pro hac vice*, to ascertain and take and state and report to the court an account of the damage sustained by the complainant, and of the gains, profits, and advantages which the said defendant has
49 received, or which have arisen or accrued to it, since the 4th day of January, 1870, from infringing the said exclusive rights of the complainant by the manufacture, use, or sale of the said improvements set forth and described in said letters patent.

Amended by order filed May 12, 1875.

And it was and is further ordered, adjudged, and decreed that the complainant, on such accounting, have the right to cause an examination of the officers and agents of the said defendants, Yale Lock Manufacturing Company, *ore tenus* or otherwise, and also the production of the books, vouchers, and documents of said Yale Lock Manufacturing Company, and that the said officers and agents at-

tend for such purpose before said master from time to time as said master shall direct, and produce said books, vouchers, and documents as ordered. And the said master is authorized and empowered to take testimony, summon witnesses, and conduct such accounting anywhere within the second circuit of the United States circuit court.

Amended by order filed May 12, 1875.

50 And it was and is further ordered, adjudged, and decreed that a perpetual injunction be issued in this suit against the said defendant, according to the prayer of the bill.

(S'g'd) N. SHIPMAN, *Judge.*

(Endorsed:) U. S. circuit court, southern district of N. Y. James Sargent, compl't, *vs.* The Yale Lock Manufacturing Company, def't, suit No. 2.

Decree. Filed April 29, 1875.

Please take notice that the within decree will be presented to the Honorable Judge Shipman for settlement at the U. S. circuit court, at the U. S. court-room, in the city of New Haven, Connecticut, on Tuesday, the 27th day of April, 1875, at the opening of the

51 court on that day, or as soon thereafter as counsel can be heard.

Yours, &c.,

(S'g'd) JAS. H. FAY,
Compl't's Solicitor.

To G. M. Plympton, Esq., def't's solicitor.

52 Circuit Court of the United States of America for the Second Circuit and Southern District of New York, as yet of the April Term, A. D. one thousand eight hundred and seventy-five.

JAMES SARGENT, Complainant,
against
THE YALE LOCK MANUFACTURING COMPANY, Defendant. } Two Suits.

HALBERT S. GREENLEAF, Complainant,
against
THE YALE LOCK MANUFACTURING COMPANY, Defendant. } One Suit.

A motion having been made to resettle and amend the decrees in these suits, and after hearing counsel, and due consideration

53 having been had, it is hereby ordered, adjudged, and decreed that the decrees in each of the said suits, entered the 29th day of April, 1875, be amended so as to read, after the words "Edward G. Thompson" in such decrees, as follows: "Who is hereby appointed master *pro hac vice*," in the place of the words "one of the masters of this court residing in the city of New York," and by the insertion after the words "and produce said books, vouchers, and documents as ordered" in such decrees, of the words:

"And the said master is authorized and empowered to take testimony, summon witnesses, and conduct such accounting anywhere within the second circuit of the United States circuit court."

And the clerk is authorized to correct the said decrees now entered and on file by making the said alterations and insertions.

(S'g'd) N. SHIPMAN, *Judge.*

54 Dated New York, May 12th, 1875.

(Endorsed:) U. S. circuit court. James Sargent *vs.* Yale Lock Man. Co. Halbert S. Greenleaf *v.* Yale Lock Man. Co. 3 suits. Amendment to decree. Filed May 12, 1875.

55 *Master's Report.*

United States Circuit Court, Southern District of New York. In Equity.

JAMES SARGENT
vs.
THE YALE LOCK MANUFACTURING COMPANY. } Suit No. 2.

Under the decree herein, entered at the April term of this court, in the year 1875, the undersigned, Edward G. Thompson, was named as master herein, *pro hac vice*, to ascertain and take, and state and report to the court an account of the damage sustained by the complainant, and the gains, profits, and advantages which the defendant has received or which have arisen or accrued to it since the 4th of January, 1870, from infringing the exclusive rights of the complainant by the manufacture, use, or sale of the improvement set forth and described in letters patent No. 98622, dated the 4th of January, 1870, granted to James Sargent, the complainant herein.

This patent is for what is known as the "Double Roller Patent."

The specification describes it as follows:

"This lock is an improvement upon that of Linas Yale, in which an eccentric roller is combined with the cam for disconcerting the action upon the tumblers. The invention consists in combining with the cam, an arrangement of two or more eccentric rollers of varying eccentricity, turning upon the same bearing, so that in revolving, one or both may turn or alternate in action, thereby

56 greatly increasing the difficulty of mapping out or locating the position of either."

The facts in this case are peculiar. In the summer of 1869, at a time and place agreed upon, the complainant Sargent picked, with the aid of a micrometer, one of the defendant's locks in a safe, and opened the safe. This picking immediately became known to the general public, and particularly to that portion of it interested in safe locks.

The natural result of such picking was that the defendant's locks were greatly damaged in their commercial value, and would have become unsaleable had not some device been discovered to protect it.

Shortly after this the complainant Sargent invented and patented a device ("The Double Roller") to prevent this picking of defendant's lock by the use of a micrometer, and this accounting is upon this patent.

The device so discovered by the complainant was of no use or

benefit to him in the manufacture of his own locks; nor was it of any use or benefit to any manufacturers of locks other than this defendant corporation.

It does not appear that Sargent ever parted with his patent, or any interest in it, or granted any license under it.

It is not a question of damages, for the complainant did not make or sell or license others to use his invention.

It is not a question of profits, because none have been shown as such.

It is a question of compensation to the complainant for the benefit derived by the defendant company from the use of his invention as to what this compensation should be.

The complainant's witness Munger (a skilled locksmith and expert in locks, and especially so in the construction of defendant's locks, from having been its employ) estimates the value of
57 complainant's device to the defendant at 10c. per lock for the double dial and No. 2 locks and 5c. for No. 3.

(See complainant's record, folio 255.)

The testimony of this witness was taken by consent on written interrogatories, and not before the master.

The value to the defendant company of complainant's device is strongly set forth in the deposition of Mr. Ira L. Cady, whose high standing and character and experience as one of the oldest dealers in locks, safes, and bank-work generally entitles his opinion to careful consideration. He says (complainant's record, folio 321): "Without something of this kind a lock" (meaning defendant's lock) "could not have been sold, and as this was the only remedy offered we laid strong stress on that in advocating its merits with the public."

The testimony of these two witnesses, however trustworthy and reliable it may be, does not form a basis upon which the master can make a computation of the money value of the device which defendant should pay to complainant. It is the opinion and estimate only of these witnesses.

It is well settled that neither profits or damages can be estimated. They must be calculated.

The defendant, however, offers a method for calculating the value of Sargent's device, for in 1872 it abandoned the use of Sargent's invention and adopted the devices claimed in a patent granted to Emory Stockwell, dated July 25, 1871, and for which it pays royalty as follows:

On the double-dial lock, per lock	----------	$1 00
On the No. 1 (old No. 2)	" ----------	75 c.
On the No. 3,	" ----------	50 c.

It is fair to believe that the patentee Stockwell, in accepting these royalties, was induced thereto by other considerations than the actual value of his invention. He had been for a long time prior to his invention, was then, and still is, in the employment of the defendant company. His time, paid for by the compnay, had been fre-

58 quently employed in experimenting for its benefit. His relations with, and continued employment by, the defendant company, must have controlled the bargain made with it for its use of this said invention.

What value, or what amount, should be added to the royalty paid Stockwell to represent these considerations?

We have two factors, one known, *i. e.*, the money value paid Stockwell, the other unknown, *i. e.*, the consideration inducing Stockwell to accept the same.

Judge McKenna, of the third circuit, in his opinion on the coming in of the master's report in the case of Wethreill *vs.* New Jersey Zinc Company, said, in substance, where there were two factors, the value or proportion of one of which was known and the other unknown, and which co-operated with each other, they must necessarily be treated as coequal in their contribution to the joint result.

Following this principle, I am of the opinion that to the royalties paid Stockwell (a known factor) there should be added an equal amount to represent the considerations (an unknown factor) which caused him to accept those royalties, to determine the fair value of his (Stockwell's) invention.

As the defendant company used the invention of the complainant until the discovery of Stockwell, it seems equitable to allow complainant for the use of his patented device an amount equal to the value above shown of Stockwell's subsequent invention during the period his device was used by the defendant.

I therefore find that the complainant should recover from the defendant company as follows:

On 250 double-dial locks, $2 per lock	$500 00
On 31 No. 1 locks, $1½ per lock	46 50
On 255 No. 3 locks, $1 per lock	255 00
Total	$801 50

All of which is respectfully submitted.

E. G. THOMPSON,
Master P. H. V.

Dated New York, August 31st, 1877.

59 United States Circuit Court, Southern District of New York.
In Equity.

JAMES SARGENT
vs.
THE YALE LOCK MANUFACTURING COMPANY. } Suit No. 2.

SIR: Please take notice that I have completed my report as master in the above-entitled cause, and shall read the same at my office, No. 16 Murray St., on Friday, Aug. 31st, at 11 a. m. You are requested to be present at that time and place.

Please take further notice that on said 31st day of August I shall fix the time within which any exceptions to this report may be filed

with me, and the time for any argument before me on such exceptions.

If no exceptions are filed before the time fixed, then the report will thereafter be filed, endorsed "that this notice was given
60 to counsel and no exceptions were filed."

Dated New York, Aug. 27, '77.

E. G. THOMPSON,
Master P. H. V.

To Edmund Wetmore, Esq.,
Counsel for Complainant,
And J. H. Betts, Esq.,
Counsel for Defendant.

(Endorsed:) Service of a copy of the within notice is hereby admitted.

N. Y., Aug. 27, 1877.

(S'g'd) EDMUND WETMORE, *B.*
(S'g'd) J. H. BETTS,
Counsel for Defendants.

61 *Master's Notice as to Report, Exceptions and Argument.*

U. S. C. C., S. D. N. Y. In Equity.

JAMES SARGENT
vs.
THE YALE LOCK M'F'G CO. } Suit No. 2.

62 United States Circuit Court, Southern District of New York.
In Equity.

JAMES SARGENT
ag'st
THE YALE LOCK MANUFACTURING CO. } Suit No. 2.

Exceptions to the master's report on behalf of the complainant.

1st. The complainant excepts to the finding of the master, that the testimony of the witnesses Munger and Cady does not form a basis upon which the master can make a computation of the moneyed value of the device which the defendant should pay the complainant, for the reason that the estimate and opinion of experts is competent evidence of value in cases like the present.

2d. The complainant excepts in that the master bases his finding of the amount due the complainant upon the royalty allowed Emory Stockwell and the circumstance of Stockwell's employment by the defendant as set forth in the master's report, and does not take into consideration not only the said circumstance but the opinions of the witnesses Munger and Cady, and the other circumstantial evidence in the case relating to the requirements of the market, the effect of the complainant's picking of the defendant's lock, the impossibility of substituting any other device except the patented device to serve the same purpose during the period when
63 said patented device was used by the defendant, and all the other evidence introduced by the complainant.

And the complainant excepts to the finding of the master, that the compensation due the complainant is eight hundred and one dollars and fifty cents for the aforesaid reason, and because it is calculated without taking into consideration all the evidence and circumstances tending to prove and establish the actual amount due from the defendant to the complainant.

EDMUND WETMORE,
Of Counsel for Complainant.

The above exceptions on the part of the complainant are severally disallowed.

(S'g'd) E. G. THOMPSON,
Master, P. H. V.

(Endorsed:) U. S. circuit court southern dist. of N. Y. In equity. James Sargent ag't The Yale Lock Manufacturing Company. Complainant's exceptions to master's report. Suit No. 2.

64 United States Circuit Court, Southern District of New York.
In Equity.

JAMES SARGENT
vs.
THE YALE LOCK MANUFACTURING COMPANY. } Suit No. 2.

Exceptions by and on the part of the Yale Lock Manufacturing Co., defendant in the above action, to the report of Edward G. Thompson, master, to whom this cause was referred by an order entered at the April term of this court, in the year 1875.

First. The said defendant excepts to the finding and report of said master, as stated in his said report, finding, reporting, and awarding any "compensation" to the plaintiff for that and because—

(*a.*) Said master had found and reported that the complainant did not suffer any damage, and that no profits on the part of the defendant were shown.

(*b.*) The interlocutory decree herein only authorized said master to assess damages and take an account of profits, and said master had no jurisdiction or power to estimate, find, or report what he deemed a compensation to the plaintiff.

Hence the said master should have declined to find or report any compensation whatever, as unsupported by any proof, and as not lying within his jurisdiction or power to report.

65 Second. The defendant further excepts to the finding and report of said master, as stated in his said report, for that he finds and reports that any compensation to the complainant could be measured by the amount of royalty paid by defendant to the patentee, Emory Stockwell, for the use of his patented device.

Whereas the said master should have found and reported that the royalties paid to said Stockwell were no measure of or guide to any compensation for the complainant.

Third. The defendant further excepts to so much of the report of

said master as states that any amount or value should be added to the royalty paid to said Stockwell.

Whereas if he adopted said royalty as a basis of compensation, he should not have added thereto.

Fourth. The defendant further excepts to so much of the report of said master as states that there were any considerations inducing said Stockwell to accept the royalty specified as paid to him, other than the mere payment thereof.

Whereas there was no evidence to support the said finding and report, and no evidence entitling or enabling the master to measure any such alleged consideration.

Fifth. The defendant also excepts to said report, for that said master erred in finding and reporting that the complainant should recover from the defendant the sum found and reported, or any sum whatsoever.

BETTS, ATTERBURY & BETTS,
Defendant's Solicitors.
FREDERIC H. BETTS, *Counsel.*

The foregoing exceptions of the defendant are severally disallowed.

E. G. THOMPSON,
Master P. H. V.

66 (Endorsed:) U. S. circuit court, southern district of New York. In equity. James Sargent *vs.* The Yale Lock Manufacturing Co. Suit No. 2. Exceptions to master's report. Betts, Atterbury & Betts, def't's sol's, 20 Nassau St.

(Endorsed over all:) United States circuit court; southern district of N. Y. In equity. James Sargent, complainant, *vs.* The Yale Lock Manufacturing Company, defendant. Suit No. 2. Master's report & exceptions. U. S. circuit court. Filed Oct. 29, 1879. John J. Davenport, clerk.

67 United States Circuit Court, Southern District of New York.
In Equity.

JAMES SARGENT
vs.
THE YALE LOCK MANUFACTURING COMPANY. } Suit No. 2.

Exceptions by and on the part of the Yale Lock Manufacturing Co., defendant in the above action, to the report of Edward G. Thompson, master, to whom this cause was referred by an order entered at the April term of this court, in the year 1875.

First. The said defendant excepts to the finding and report of said master, as stated in his said report, finding, reporting, and awarding any "compensation" to the plaintiff, for that and because—

(*a.*) Said master had found and reported that the complainant did not suffer any damage, and that no profits on the part of the defendant were shown.

(*b.*) The interlocutory decree herein only authorized said master to assess damages and take an account of profits, and said master had no jurisdiction or power to estimate, find, or report what he deemed a compensation to the plaintiff.

Hence the said master should have declined to find or report any compensation whatever, as unsupported by any proof, and as not lying within his jurisdiction or power to report.

68 Second. The defendant further excepts to the finding and report of said master, as stated in his said report, for that he finds and reports that any compensation to the complainant could be measured by the amount of royalty paid by defendant to the patentee, Emory Stockwell, for the use of his patented device.

Whereas the said master should have found and reported that the royalties paid to said Stockwell were no measure of or guide to any compensation for the complainant.

Third. The defendant further excepts to so much of the report of said master as states that any amount or value should be added to the royalty paid to said Stockwell.

Whereas, if he adopted said royalty as a basis of compensation, he should not have added thereto.

Fourth. The defendant further excepts to so much of the report of said master as states that there were any considerations inducing said Stockwell to accept the royalty specified as paid to him other than the mere payment thereof.

Whereas there was no evidence to support the said finding and report, and no evidence entitling or enabling the master to measure any such alleged consideration.

Fifth. The defendant also excepts to said report, for that said master erred in finding and reporting that the complainant should recover from the defendant the sum found and reported, or any sum whatsoever.

BETTS, ATTERBURY & BETTS,
Defendant's Solicitors.
FREDERIC H. BETTS, *Counsel.*

69 (Endorsed:) U. S. circuit court, southern district of N. Y. James Sargent *vs.* The Yale Lock M'f'g Co. Suit No. 2. In equity. Exceptions to master's report. Betts, Atterbury & Betts, def't's sol'rs, 20 Nassau St. U. S. circuit court. Filed Oct. 24, 1877. John I. Davenport, clerk.

70 United States Circuit Court, Southern District of New York.

JAMES SARGENT *vs.* THE YALE LOCK M'F'G CO. } No. 1.

SAME *vs.* SAME. } No. 2.

HALBERT S. GREENLEAF *vs.* SAME.

I hereby consent that Messrs. Betts, Atterbury & Betts be substi-

tuted as solicitor for the defendant in the above entitled suits in my place.

New York, January 16th, 1878.

G. M. PLYMPTON,
Sol'r for Def'ts.

71 (Endorsed:) U. S. circuit court, south. dist. of N. Y. James Sargent *vs.* The Yale Lock M'f'g Co., and two other cases. Consent to substitute solicitors. U. S. circuit court. Filed Jan. 17, 1878. John I. Davenport, clerk.

72 At a stated term of the circuit court of the United States for the southern district of New York, in the second circuit, held at the United States court-rooms, in the City of New York, on Tuesday, the twenty-second day of October, in the year of our Lord one thousand eight hundred and seventy-eight.

Present: The Honorable Samuel Blatchford, circuit judge.

JAMES SARGENT
vs.
THE YALE LOCK MANUFACTURING COMPANY. } No. 1.

SAME
vs.
SAME. } No. 2.

HALBERT S. GREENLEAF *vs.* SAME.

The above causes coming on for argument together on exceptions to the master's report:

Mr. Frederick H. Betts is heard in behalf of the defendants.

(Further argument adjourned to the 23rd instant.)

73 At a stated term of the circuit court of the United States of America for the southern district of New York, in the second circuit, held at the United States court-rooms, in the city of New York, on Wednesday, the twenty-third day of October, in the year of our Lord one thousand eight hundred and seventy-eight—

Present: The Honorable Samuel Blatchford, circuit judge.

JAMES SARGENT
vs.
THE YALE LOCK MANUFACTURING COMPANY.

SAME *vs.* SAME.

HALBERT S. GREENLEAF *vs.* SAME.

The argument of the exceptions to the master's report in the above causes being resumed—

Mr. F. H. Betts continues his argument in behalf of the defendants.

Mr. Edmund Wetmore is heard in behalf of the complainants.

(Further argument adjourned to the 24th inst.)

74 At a stated term of the circuit court of the United States of America for the southern district of New York, in the second circuit, held at the United Sates court-rooms, in the city of New York, on Thursday, the twenty-fourth day of October, in the year of our Lord one thousand eight hundred and seventy-eight—

Present: The Honorable Samuel Blatchford, circuit judge.

JAMES SARGENT
vs.
THE YALE LOCK MANUFACTURING COMPANY.

SAME *vs.* SAME.

HALBERT S. GREENLEAF *vs.* SAME.

The argument in the above causes being resumed—

Mr. Wetmore continues his argument in behalf of the complainants.

Mr. George Ticknor Curtis is heard in behalf of the complainants.

Mr. George T. Betts is heard in behalf of the defendants.

Curia advisari vult.

75 Circuit Court of the United States for the Southern District of New York.

JAMES SARGENT
vs.
THE YALE LOCK MANUFACTURING COMPANY. } Suit No. 2.

BLATCHFORD, *J.*:

By the interlocutory decree in this case it was referred to the master "to ascertain and take and state and report to the court an account of the damage sustained by the complainant, and of the gains, profits, and advantages which the said defendant has received, or which have arisen or accrued to it since the 4th day of January, 1870, from infringing the said exclusive rights of the complainant by the manufacture, use, or sale of the said improvements set forth and described in said letters patent."

The master reports that in the summer of 1869, the plain-
76 tiff had picked a lock of the defendant's in a safe; that this made it necessary to discover a device to protect such lock; that the plaintiff then invented for such purpose the device covered by the patent in suit; that this accounting is upon such patent; that the device so patented was of no use or benefit to the plaintiff in the manufacture of his own locks, and was of no use or benefit to any manufacturers of locks other than the defendant; that the plaintiff never parted with his patent, or any interest in it, or granted any license under it; that it is not a question of damages, for the plaintiff did not make or sell or license others to use his invention; that it is not a question of profits, because none have been shown as such; and that it is a question of compensation to the plaintiff for the benefit derived by the defendant from the use
77 of his invention. The master then sets forth that a witness,

Munger, estimated the value of the plaintiff's device to the defendant at $10 per lock for the double-dial and No. 2 locks, and $5 for No. 3; and he also sets forth the testimony of a witness, Cady, as to the value of the plaintiff's device to the defendant, and he adds that the testimony of those two witnesses does not form a basis upon which the master can make a computation of the money value of the device which the defendant should pay to the plaintiff, it being the opinion and estimate only of those witnesses. The master then proceeds to say: "The defendant, however, offers a method for calculating the value of Sargent's device, for in 1872 it abandoned the use of Sargent's invention and adopted the devices claimed in a patent granted to Emory Stockwell, dated July 25th, 1871,
78 and for which it pays royalty as follows: on the double-dial lock, per lock, $1.00; on the No. 1 (old No. 2), 75 cents; on the No. 3, 50 cents. It is fair to believe that the patentee, Stockwell, in accepting those royalties was induced thereto by other considerations than the actual value of his invention. He had been, for a long time prior to his invention, was then, and still is, in the employment of the defendant company. His time, paid for by the company, had been frequently employed in experimenting for its benefit. His relations with and continued employment by the defendant company must have controlled the bargain made with it for its use of his said invention. What value or what amount should be added to the royalty paid Stockwell to represent these considerations?

79 We have two factors, one known, *i. e.*, the money value paid Stockwell; the other unknown, *i. e.*, the consideration inducing Stockwell to accept the same. Judge McKennan, of the third circuit, in his opinion on the coming in of the master's report in the case of Witherill *v.* The New Jersey Zinc Company, said, in substance, that where there were two factors, the value or proportion of one of which was known and the other unknown, and which co-operated with each other, they must necessarily be treated as coequal in their contribution to the joint result. Following this principle, I am of the opinion that to the royalties paid Stockwell (a known factor) there should be added an equal amount to represent the considerations (an unknown factor) which caused him to accept those royalties, to determine the fair value of his (Stockwell's) invention. As the
80 defendant company used the invention of the complainant until the discovery of Stockwell, it seems equitable to allow complainant for the use of his patented device an amount equal to the value, above shown, of Stockwell's subsequent invention during the period his device was used by the defendant. I therefore find that the complainant should recover from the defendant company as follows: On 250 double-dial locks, $2 per lock, $500.00; on 31 No. 1 locks, $1.50 per lock, $46.50; on 255 No. 3 locks, $1 per lock, $255.00; total, $801.50.

The plaintiff excepts to the finding of the master that the testimony of the witnesses, Munger and Cady, does not form a basis upon which the master can make a computation of the money value of the device which the defendant should pay to the plaintiff,

81 for the reason that the estimate and opinion of experts is competent evidence of value in cases like the present. The plaintiff also excepts, in that the master bases his finding of the amount due the plaintiff on the royalty allowed Emory Stockwell, and the circumstances of Stockwell's employment by the defendant, as set forth in the report, and does not take into consideration, not only the said circumstance, but the opinions of the witnesses, Munger and Cady, and the other circumstantial evidence in the case relating to the requirements of the market, the effect of the plaintiff's picking of the defendant's lock, the impossibility of substituting any other device except the patented device, to serve the same purpose, during the period when said patented device was used by the defendant, and all the other evidence introduced by the

82 plaintiff. The plaintiff also excepts to the finding of the master that the compensation due to the plaintiff is $801.50, for the aforesaid reason, and because it is calculated without taking into consideration all the evidence and circumstances tending to prove and establish the actual amount due from the defendant to the plaintiff.

The defendant excepts to the finding and report of the master awarding any "compensation" to the plaintiff, because the master had reported that the plaintiff "did not suffer any damage," and that no profits on the part of the defendant were shown, and because the interlocutory decree only authorized the master to assess damages and take an account of profits, and the master had no jurisdiction or power to estimate, find or re-

83 port what he deemed a compensation to the plaintiff. The defendant also excepts because the master reports that any compensation to the plaintiff could be measured by the amount of royalty paid by the defendant to Stockwell for the use of his patented device. It also excepts to so much of the report as states that any amount or value should be added to the royalty paid to Stockwell; and to so much of the report as states that there were any considerations inducing Stockwell to accept the royalty specified as paid to him, other than the mere payment thereof; and to the finding that the plaintiff should recover from the defendant the sum reported or any sum.

The master was right in reporting a compensation to the plaintiff. Such compensation was either damages to the plaintiff or advantage to the defendant. It was the value of the use of the inven-

84 tion to the defendant. The defendant's lock became unsaleable, and the use of the plaintiff's patented device restored its saleable character. By using such device the defendant was saved from loss. This was an advantage which, on proper evidence, may be occasioned by a money value and recovered. (Cawood Patent, 4 Otto, 695, 710.)

I think the master was right in rejecting the estimate of the witness Munger, and the general evidence of the witness Cady. I also think that under the circumstances of this case, the proper measure of the value of the invention to the defendant was the amount it paid Stockwell for a license under his patent, and that there is

no sufficient ground in the evidence for adding anything to that amount. The amount of the plaintiff's recovery must be
85 limited to $400.75. The plaintiff's exceptions are disallowed. Exceptions one, two, and five of the defendant are disallowed, and exceptions three and four of the defendant are allowed.

EDMUND WETMORE and
GEORGE T. CURTIS,
For the Plaintiff.
RODERIC H. BETTS,
For the Defendant.

Endorsed: Circuit court of the United States for the southern district of New York. James Sargent *vs.* The Yale Lock M'f'g Co. Suit No. 2. Decision Oct. 29th, 1879. U. S. circuit court. Filed Oct. 29, 1879. John I. Davenport, clerk.

86 At a stated term of the circuit court of the United States for the second circuit and southern district of New York, held at the United States court-house, in said city, on the —— day of February, A. D. 1881.

Present: The Honorable Samuel Blatchford, judge.

JAMES SARGENT, Complainant,
ag'st
THE YALE LOCK MANUFACTURING COMPANY, Defendant. } Suit No. 2.

This cause having come on to be further heard on the complainant's exceptions to the master's report, which said report was made and dated the 31st day of August, 1877, and also upon the
87 defendant's exceptions to said report, and after hearing Mr. Curtis and Mr. Wetmore, complainant's counsel, in support of the complainant's exceptions and in opposition to the defendant's exceptions, and Mr. George T. Betts and Mr. Frederic H. Betts, defendant's counsel, in support of the defendant's exceptions and in opposition to the complainant's exceptions, and consideration having been had, and the opinion of the court upon said exceptions having been filed the 29th day of October, 1879, and the complainant's costs and disbursements having been duly taxed by the clerk at three hundred thirty-five $\frac{75}{100}$ dollars—

It is hereby ordered, adjudged, and decreed that the said complainant's exceptions and the first, second, and fifth of the defendant's exceptions be, and they hereby are, disallowed, and the
88 third and fourth of said defendant's exceptions be, and they hereby are, allowed; and that the complainant recover of the defendant and the defendant pay to the complainant the sum of four hundred dollars and seventy-five cents damages, and three hundred thirty-five dollars and seven cents costs, in all the sum of seven hundred and thirty-five dollars and eighty-two cents, together with interest thereon from the date of the entry of this decree, and that the complainant have execution therefor.

(S'g'd) SAM'L BLATCHFORD.

Form approved.
(S'g'd) BETTS, ATTERBURY & BETTS,
Def't's Sol'rs.

(Endorsed:) U. S. circuit court, southern dist. of New York.
89 James Sargent ag'st The Yale Lock Manufacturing Company. No. 2. Final decree. (File mark.) U. S. circuit court. Filed Feb. 3. 1881. Joseph M. Deuel, clerk.

90 U. S. Circuit Court, Southern District of New York.

JAMES SARGENT
vs.
THE YALE LOCK MANUFACTURING COMPANY.
HALBERT S. GREENLEAF
vs.
THE SAME.
} Suits Nos. 1 & 2.

It is hereby stipulated between the solicitors for the respective parties in the above-entitled causes that the master's reports and exceptions herein, endorsed as having been filed in the clerk's office of said court on the 29th of October, 1879, be, and the same are hereby, considered as having been duly filed in said office on the 24th of September, 1877, *nunc pro tunc*.

JAMES H. FAY,
Complainant's Solicitor,
Per E. W.

New York, Oct. 12, 1882.

91 (Endorsed:) U. S. circuit court, southern district of N. Y. Sargent *vs.* The Yale Lock M'f'g Co. Suits Nos. 1 and 2. Greenleaf *vs.* The Same. Stipulation as to filing master's reports and exceptions *nunc pro tunc* as of Sept. 24. 1877. U. S. circuit court. Filed Oct. 12, 1882. Joseph M. Deuel, clerk.

92 U. S. Circuit Court, Southern District of New York.

JAMES SARGENT
vs.
THE YALE LOCK M'F'G CO.
} Suit No. 1.

JAMES SARGENT
vs.
THE YALE LOCK M'F'G CO.
} Suit No. 2.

HALBERT S. GREENLEAF
vs.
THE YALE LOCK M'F'G CO.
} Suit No. 3.

It is hereby stipulated that all the testimony taken before the master in the accounting in the above-entitled suits, copied and certified by the clerk of this circuit court in suit No. 1 above entitled, be considered as the record of the testimony before the master in suits Nos. 2 and 3 above entitled as fully as if separately
92½ certified and printed in each suit.

It is also further stipulated that the exhibits other than documentary in all the above suits be retained by the clerk of this

court until the hearing of the appeals herein before the Supreme Court or by the respective counsel, as to them shall seem fit.

And it is also further stipulated that the defendant's exhibits Towne, and the file wrapper and contents of the application of Sargent for original and reissued patents, noted as put in evidence at p. 50 of defendant's proof, as paged in the circuit copy of record, but of which the originals appear to be not now on file, may be considered to be the Patent Office copies thereof; and it is stipulated that such copies may be regarded as original exhibits, and that they be part of the record; and it is further stipulated that such
93 copies of exhibits may be retained by counsel for completion, and forwarded to the clerk of the Supreme Court after the 13th of October, 1882, and that drawings of complainant's patents in suit may be in like manner filed *nunc pro tunc* or retained and forwarded to the clerk of the Supreme Court as above.

BETTS, ATTERBURY & BETTS,
Sol'rs for Def'ts.
JAMES H. FAY, *Solicitors for Compl'ts.*

(Endorsed:) U. S. Circuit court, southern dist. of N. Y. Sargent *v.* The Yale Lock M'f'g Co.; suit No. 1. Sargent *v.* The Yale Lock M'f'g Co.; suit No. 2. Greenleaf *v.* The Yale Lock M'f'g Co.; suit No. 3 Stipulation. Filed Oct. 12, 1882. T.

94 Circuit Court of the United States, Southern District of New York. In Equity.

JAMES SARGENT
vs.
THE YALE LOCK MANUFACTURING COMPANY. } No. 2.

To the honorable the Supreme Court of the United States:

The appeal of The Yale Lock Manufacturing Company, the above-named defendant and appellant, respectfully showeth:

That upon the 15th day of July, 1872, the above-named complainant filed his bill in the circuit court of the United States for the southern district of New York against the above-named defendant and appellant in a suit in equity to enjoin and restrain the said The Yale Lock Manufacturing Company from infringing certain
95 letters patent No. 98622, granted to complainant on January 4th, 1870, and praying for an injunction restraining defendant and an accounting and payment by the said defendant of the profits by it realized and of the damages suffered by the said James Sargent by reason of said alleged infringement of said letters patent, and that a subpœna *ad respondendum* issue out of and under the seal of said circuit court.

That said defendant filed its answer to said bill of complaint and denied any infringement, alleging prior use and sale, and that the complainant was not the original and first inventor of the invention alleged to be infringed, and that the said letters patent are invalid and fraudulently obtained.

That thereupon the complainant herein filed a replication thereto,

and, that issue being thus joined, such proceedings were had
96 that an interlocutory decree was entered ordering an injunction and an accounting and an assessment. That such accounting and assessment were had, and a report made and filed by the master, to which exceptions were filed by the defendant, and after hearing certain of said exceptions were overruled, and said report was modified and confirmed in part. That subsequently and on the 3rd day of February, 1881, a final decree was made and entered in the cause, wherein it was adjudged that the complainant should recover of the defendant the sum of $735.82 dollars and be awarded other relief.

Wherefore this appellant appeals from the whole of said decree of said circuit court, and from the said interlocutory decree, and every part thereof, and from all orders overruling the defendant's
97 exceptions, and every part thereof, upon which said decree was founded, and respectfully prays that the decree of the said circuit court and the bill, answer, pleadings, depositions, evidence, orders, and proceedings in the said cause may be sent to the Supreme Court of the United States without delay, and that the said Supreme Court will proceed to hear the said cause anew, and that the said decree of the circuit court and every part thereof may be reversed and a decree made dismissing said bill, or such other decree made as to the said Supreme Court shall seem just.

Dated N. Y., May 8th, 1882.

FREDERIC H. BETTS,
Solicitor & of Counsel.

Allowed.

ADDISON BROWN,
District Judge of Southern District of New York in the Second Circuit.

98 (Endorsed:) James Sargent *vs.* The Yale Lock Manufacturing Company. No. II. Petition of appeal. Betts, Atterbury & Betts, def't's & app'l't's sol'rs, 120 B'way, N. Y. Due service of a copy of the within writ is hereby admitted. N. Y., May 11th, 1882. Edmund Wetmore, of counsel. U. S. circuit court. Filed May 15, 1882. Joseph M. Deuel, clerk.

99 *Bond for Damages and Costs.*

Circuit Court of the United States of America for the Southern District of New York, in the Second Circuit.

JAMES SARGENT
vs.
THE YALE LOCK MANUFACTURING COMPANY. } Case 2.

Know all men by these presents that we, The Yale Lock M'f'g Company, as principal, and Henry R. Towne and Schuyler Merritt, as sureties, all of Stamford, Conn't, are held and firmly bound unto the above-named James Sargent in the sum of one thousand four hundred and seventy-one $\frac{64}{100}$ dollars, to be paid to the said James

Sargent, his executors or administrators; for the payment of which, well and truly to be made, we bind ourselves, and each of us, our and each of our heirs, executors, and administrators, jointly and severally, firmly by these presents.

Sealed with our seals, and dated the 29 day of June, in the year of our Lord one thousand eight hundred and eighty-one.

Whereas the above-named The Yale Lock Manufacturing Company has prosecuted an appeal to the Supreme Court of the United States to reverse the judgment and decree rendered in the above-entitled suit by the judge of the circuit court of the United States for the southern district of New York:

Now, therefore, the condition of this obligation is such, that if the above-named The Yale Lock Manufacturing Company shall prosecute their appeal to effect and answer all damages and costs, if they, The Yale Lock Manufacturing Company, fail to make their plea good, then this obligation shall be void; otherwise, the same shall be and remain in full force and virtue.

[Seal of the Yale L. M. Co.]

THE YALE LOCK M'F'G CO.,
By HENRY R. TOWNE, *Pres't.*
HENRY R. TOWNE. [L. S.]
SCHUYLER MERRITT. [L. S.]

Sealed and delivered and taken and acknowledged, this 29 day of June, 1881, before me.

[NOTARIAL SEAL.] EDWARD W. RIKER,
Notary Public.

100 UNITED STATES OF AMERICA, }
District of Connecticut, } *ss.:*

Henry R. Towne and Schuyler Merritt, being duly sworn, depose and say, each for himself, that he is worth the sum of two thousand dollars over and above all his just debts and liabilities.

HENRY R. TOWNE.
SCHUYLER MERRITT.

Sworn to, this 29 day of June, A. D. 1881, before me.

[NOTARIAL SEAL.] EDWARD R. RIKER,
Notary Public.

Approved as to form and sufficiency.

ADDISON BROWN.

[Endorsed:] Case 2. U. S. circuit court. James Sargent *vs.* The Yale Lock Manufacturing Company. Bond for damages and costs on appeal to the Supreme Court. Approved as to form. Edmund Wetmore, of counsel for comp'l't. U. S. circuit court. Filed May 8, 1882. Joseph M. Deuel, clerk.

101 Circuit Court of the United States for the Southern District of New York. In Equity.

JAMES SARGENT
vs.
THE YALE LOCK MANUFACTURING COMPANY. } No. II.

By the Honorable Addison Brown, district judge for the southern district of New York to James Sargent:

Whereas the Yale Lock Manufacturing Company has lately appealed to the Supreme Court of the United States from a decree lately rendered in the circuit court of the United States for the southern district of New York, made in favor of you, the said James Sargent, and has filed the security required by law, you are, therefore, hereby cited to appear before the said Supreme Court, at the city of
102 Washington, D. C., on the second Monday of October next, to do and receive what may appertain to justice to be done in the premises.

Given under my hand at the city of New York, in the southern district of New York, in the second circuit, the 8th day of May, in the year of our Lord 1882.

ADDISON BROWN.

(Endorsed:) U. S. circuit court, southern district of New York. James Sargent *vs.* The Yale Lock M'f'g Co. No. II. Citation. Betts, Atterbury & Betts, 120 B'way, def't's & app'l'ts' att'ys. Due service of a copy of the within is hereby admitted. N. Y., May 11th, 1882. Edmund Wetmore, of counsel. (File mark.) U. S. circuit court. Filed May 15, 1882. Joseph M. Deuel, clerk.

103 UNITED STATES OF AMERICA, } *ss:*
Southern District of New York, }

I, Joseph M. Deuel, clerk of the circuit court of the United States of America for the southern district of New York, in the second circuit, do hereby certify that the foregoing pages, numbered from one to one hundred and two, inclusive, of the record and proceedings had in said court, in the case of James Sargent against The Yale Lock Manufacturing Company, No. 2, as the same remain of record and on file in said office.

In testimony whereof, I have caused the seal of the said court to be hereunto affixed at the city of New York, in the southern district of New York, in the second circuit, this 13th day of October, in the year of our Lord one thousand eight hundred and eighty-two, and of the Independence of the United States the one hundred and seventh.

[Seal of U. S. circuit court, south. D. New York.]

JOSEPH M. DEUEL, *Clerk.*

Endorsed on cover: S. New York C. C. U. S. No. 165. The Yale Lock Manufacturing Company, appellant, *vs.* James Sargent. Filed 7th November, 1882.

SUPREME COURT OF THE UNITED STATES.

YALE LOCK MANUFACTURING COMPANY

vs.

JAMES SARGENT.

No. 165,
October Term, 1885.

STATEMENT.

The bill in this case is filed to restrain the alleged infringement of the letters patent granted to the complainant for improvement in permutation locks, dated January 4th, 1870, No. 98,622.

The bill was filed January 10th, 1872, alleging the grant of the patent, and charging infringement in the usual form (Record, pp. 1–3).

The answer was filed November 6th, 1872 (p. 6), and presents the following defenses:

1. Prior knowledge and use of the invention by Emory Stockwell, Henry R. Towne and others (p. 4–5).

2. Denies infringement (p. 5, fol. 11).

Replication was filed, and proofs taken.

The cause came on to be heard before his Honor, Judge Nathaniel Shipman.

On the 29th day of April, 1875, a decree was rendred in favor of the complainants for an injunction, account and assessment of damages (Record, p. 25).

No opinion was rendered.

The case proceeded before the Master, E. G. Thompson, Esq., from May, 1875, to August, 1877.

On the 31st day of August, 1877, the Master rendered a report (pp. 27–29), finding that *no profits had been shown* to have been re-

ceived by the defendant (p. 28, fol. 56), and finding that *no damages had been suffered* by the complainant, because he had neither made, sold, or licensed to others the lock in question (pp. 28, fol. 56), but awarding a recovery to the complainant on the basis of what he calls "*compensation* to the complainant for the benefit derived by the *defendant*," in the sum of $801.50 (p. 29).

Exceptions were filed to this report by both parties (pp. 30 and 31).

It was contended by the complainant's exceptions that a recovery should have been awarded on the basis of an estimate by the witnesses, Munger and Cady (Record, p. 30).

It was contended by the defendant's exceptions that nothing should have been awarded (Record, p. 32), in view of the fact that the Master had himself found that neither profits nor damages were shown.

The Court (Mr. Justice BLATCHFORD), on October 29, 1879, filed an opinion overruling all of the complainants' exceptions, and sustaining so much of the defendants' exceptions as reduced the amount reported to $400.75, and overruled the rest (Record, pp. 35–38).

A decree was thereupon entered in favor of the complainant and against the defendant for the sum of $400.75, with interest and costs (Record, p. 38).

From this decree the defendants appealed (Record, p. 40).

No appeal has been taken by the complainants.

Assignment of Errors.

1st. The Court erred in decreeing that the defendants had infringed the Sargent patent.

2d. The Court erred in not holding that the devices and arrangement of the defendants' lock were adopted prior to the date of Sargent's patent, and prior to any date of invention proved by him, and that such devices could not be legally included in the patent.

3d. The Court erred in confirming the Master's report and adjudging any recovery to the complainant.

(*a*) Because on the face of the report the Master found that neither profits or damages were proved.

(*b*) Because there was no authority by statute, or otherwise, to award "compensation" to a plaintiff where neither "profits" nor "damages" were shown.

(*c*) Because there was no *competent* evidence before the Master upon which to base any recovery.

4th. The Court erred in rendering any decree in favor of the complainant.

FIRST POINT.

The defendants' lock does not infringe the complainant's patent.

The complainant's patent will be found at pages 10–11.

Mr. Sargent states in the preamble of his patent that the lock patented by him is an improvement upon that of Linus Yale, in which "an eccentric roller is combined with the cam for disconcert-"ing the action upon the tumblers."

The patent, therefore, is for a mere improvement upon a pre-existing device, and that, too, upon a device patented by the originator of the defendant company.

The specification then goes on to describe the nature of the invention in the following words; (the italics are ours):

"The invention consists in combining with the cam an arrange-"ment of two or more eccentric rollers, *of varying eccentricity*, "turning upon the same bar, so that, in revolving, one or both of "them may turn and alternate in action, thereby greatly increasing "the difficulty of mapping out or locating the position of either."

The description then refers to the other parts of the lock, which, however, it says are not of any special construction, but "the "ordinary parts employed in combination locks," and "need no "special description here."

The specification then says:

"A single eccentric roller H, pivoted at *a* to a suitable arm or "bearing and resting upon the cam D, has been before employed, as "already stated. Its object is to disconcert the action inside the "lock, so that an expert lock-picker or burglar cannot tell the posi-"tion of the tumblers when operating upon the lock."

It is conceded, therefore, that every part of the lock shown in the drawing was old and had been previously used in the same way

as shown in the drawings, except that upon the shaft *a*, in the older form, was a single eccentric roller.

The improvement now sought to be patented is simply the addition of another part.

After stating that experiment has shown that by the use of a delicate instrument the prior lock of Linus Yale could be picked, owing to the possibility of ascertaining by manipulation the shape of this roller, the patentee says:

"To obviate this difficulty *as far as possible* I combine with this "roller one or more rollers H, pivoted to the same arm or bearing, "and resting upon the periphery of the cam in the same manner, "but all these rollers are made of *varying eccentricity* and of *differ-* "*ent shape*, and, *therefore*, when the cam is turned the several rol- "lers strike at different positions, and, when one touches the others "may be removed from contact, thus alternating in action. They "may also turn in different directions."

"*By this means*, owing to the different contact of the several "rollers, the difficulty of mapping out and locating the same is *very* "*greatly increased*."

We have italicized the words in the above quotation to which we specially desire to call attention.

The claim is in the following words:

"The arrangement of two or more rollers H and H^1, *of varying* "*eccentricity*, when combined with the cam in the manner and for "the purpose specified."

The defendant's lock, marked "Exhibit Cole, No. 1," is a combination lock having a case, wheels or tumblers, a spindle, a cam, a dog which falls to release the bolt, and a bolt. It also has an eccentric roller combined with the cam, and is, therefore (as Sargent's was), a lock of the same kind as the lock of Linus Yale, upon which the Sargent patent is alleged to be an improvement.

The question is whether the defendant's lock has also the *particular* improvement which is claimed by Sargent.

The Sargent claim is for an improvement which consists in the combination with the cam of "two or more rollers, H H^1, of *varying eccentricity*."

Mr. H. B. Renwick, complainant's expert, explains these words in the following statement (p. 9):

"I have examined the patent, and believe that the words 'varying "eccentricity,' as applied to the rollers, mean that the rollers shall "have their axes at different points in their diameters."

It is this particular improvement, and no other, which is claimed.

The defendant's lock *does not* have, combined with its cam, two or more rollers *of varying eccentricity.*

Mr. H. B. Renwick, the complainant's expert, says (p. 9, x-Q. 5):

"I cannot tell with certainty whether they are or are not of "varying eccentricity."

And again (p. 8, Q. 4):

"Whether these rollers in the exhibit are of varying eccentric-"ity or not I cannot positively determine, although they appear to "be so by examination of them without instruments. A variation "of eccentricity between the two rollers, which could be measured "by the micrometer only, would be sufficient to secure the objects "these rollers are designed to effect, and they may have such ec-"centricity and yet it may be impossible to determine it by the eye "alone."

Mr. Renwick does not appear to have tested the rollers of the defendant's lock by a micrometer, or, *if* he did, *he fails* to give us the result of any such test.

Mr. Towne, president of the defendant company, says expressly that the rollers used in the defendant's lock are *not* of varying eccentricity.

He says (p. 13, Q. 5):

"No pair of rollers was made by us, the disks composing which "were of varying eccentricity or of different shapes. As I have "before stated, the two disks of each pair of rollers were precisely "alike, both in shape and eccentricity. The device described by "the patent referred to, consisting of a pair of rollers of different "shape and varying eccentricity, was not made or used by us in any "way or for any purpose."

Mr. Emory Stockwell, superintendent of the defendant company, describes the method of making these rollers (p. 16, Q. 4), which was

to turn both rollers up to their required shape when placed together upon an eccentric chuck.

He produces the chuck (Q. 6); and is asked (Q. 5):

"Q. From the manner you have described of making these discon-
"certer rollers, *is it possible* to make these rollers of varying eccen-
"tricity and of different shapes?"

"A. It is not."

Mr. Towne, after describing the mode of fastening the metal into the chuck for the purpose of turning them into shape, says (p. 12, Q. 4):

"In this position they were rigidly clamped together, so that
"while in the lathe they became virtually one solid piece of metal.
"The cutting tool in the slide rest of the lathe was then brought
"against the periphery of the two disks, and the peripheries
"turned and finished thereby, thus making the form and eccen-
"tricity of the two disks, comprising a pair of rollers, *identical*
"*and precisely the same.* The rollers, when taken from the chuck,
"were carefully strung together in pairs as they were made, our
"object being that each roller of a pair should be *precisely the sim-*
"*ilar to its mate.*"

Mr. E. S. Renwick examined the chuck and says (pp. 18–19, Q. 5): "With both rollers, screwed in this manner, and both turned
"simultaneously, it will be practically impossible to make the
"rollers of varying eccentricity."

Upon examining the rollers in the defendant's lock, he says (Q. 6):

"As far as I can determine by the eye, the eccentricity of the
"two rollers referred to in the question appears to be the same, but
"the forms of the rims of the rollers have apparently been changed
"by hammering them since they have been turned, so that the two
"rollers are not precisely the same shape."

Mr. Sargent, the complainant himself, is the only other witness called on his own behalf.

He was not examined or cross-examined orally, but written interrogatories and cross-interregatories appear to have been addressed to him (Record, pp. 20–24).

Upon examining his deposition it will be found that the specimen of defendant's lock, "Exhibit Cole No. 1," "was obtained from

" the Yale Lock Manufacturing Company a short time before it was " put in evidence in this case" (p. 23, x-Q. 1).

In answer to x-Q. 7, he says:

" I remember examining the bolts and the rollers carefully at the " time the lock was put in evidence in this suit. If there had been any " marks of violence, battering or mutilation of the peripheries, it " would have attracted my attention, and I would have remembered " it. My attention was first called to the fact, (if a fact), by the de- " fendants' testimony of it in this suit. Whether said rollers have " now any marks of violence, battering or mutilation I know not. I " do not know that they have had such marks, or any marks other " than proper usage would necessarily produce."

It would appear by the testimony of Sargent, therefore, that the marks of hammering, which Mr. Renwck and Mr. Towne (p. 13, Q. 7), detected in the defendant's lock were not present when the lock was first purchased.

Sargent, therefore, had before him a specimen of the defendants' lock which he could have accurately measured, *if he had wished*, to determine whether the rollers varied in eccentricity.

He did not do so, but is contented with the following generalities:

In Question 10, the witness, Sargent, is asked:

" Would it or not be possible (in your judgment as a mechanic), " to make such rollers, in the manner described by the defendant's " witnesses, so that they would be exactly of the same eccentricity " and shape, without a difference between them sufficient to be " measured by the micrometer?" He answers (p. 23):

" A. In my judgment it would not be possible."

In answer to the fifth question he testifies (p. 22–23), that he has a micrometer and that,—

" The micrometer is an instrument capable of measuring the " difference of the two-thousandth part of an inch in the diameter " of wheels."

It is to be noticed that *he is not asked* whether he has ever tested, with this delicate micrometer, the two rollers in the sample of the defendants' lock, although he expressly testified that, he carefully examined it, and that at the time, there were no marks of violence, battering or mutilation upon it.

By the eighth cross-interrogatory he was asked (p. 22) to

"State if you have tried to make such rollers in the manner in-
" quired of (by defendant's apparatus) so that they would be exactly
" the same; and if you say you have, did you test them with the
" micrometer; if yes, when and where and under what circum-
" stances and with what results?" And he answers, (and the circumspection of the answer is to be noted), (p. 24):

"A. I have many times tried to make rollers in the manner in-
" quired of, so they would be exactly the same, and I have tested
" them with the micrometer. I have tested with the micrometer
" two disconcerting rollers, made in the manner inquired of, at my
" factory in Rochester, N. Y., in 1870, and by this means found
" them unlike."

This *unlike* pair that he tested, (and he does not say that he ever found any others that were unlike), may have been the single and only pair of rollers which he ever made, and those attached to his model, upon obtaining his patent. (At a subsequent stage of the case, on the accounting this was admitted to be the case. Record No. 164, p. 142, fol. 245.)

In Cross-interrogatory 9 (p. 24) he was asked:

" Q. If you state that you did test such rollers by a micrometer,
" were the rollers, so tested, two disconcerting rollers fixed to the
" fence lever of the lock, and were such rollers manufactured by the
" defendant or not?"

And he answers:

" A. The rollers tested were two disconcerting rollers; some of
" them was fixed to the fence lever of the lock and some were not;
" *some were manufactured by the defendant*, and some were not."

It appears, therefore, by this answer that the complainant has tested more than one pair of disconcerting rollers, and that some of those pairs were made by the defendant and others by himself. Yet, it will be noticed that he carefully avoids saying that any of such disconcerting rollers had even such an amount of varying eccentricity, as could be detected by the micrometer.

Cross-question 12 makes this even more certain. In that interrogatory he is asked (p. 22):

Q. " Did you ever test by a micrometer the disconcerting roll-
" ers attached to the lock, 'Exhibit Cole No. 1;' if yes, when and
" where, and under what circumstances and with what results?"

And he answers (p. 24):

A. I never did.

As Mr. Sargent admits that he is in the possession of, and accustomed to the use of a micrometer, capable of measuring the variations of even the two-thousandth of an inch, and as he admits that he has tested some of the disconcerting rollers of the defendant's locks, and that he had carefully examined the rollers of the lock put in evidence, yet he had never tested them, and as he fails to state that he has ever detected even the smallest and slightest variation in the eccentricity of the rollers *in any of the defendant's locks*, it must be assumed that those rollers are, as the defendants say, of precisely the same shape and of precisely the same eccentricity, and that therefore they have not the peculiar characteristic named as a feature of the claim of the complainant's patent; viz., that the two rollers must be, not any rollers but the "rollers H H," which are "of varying eccentricity," and, as the description says, "of different shape."

The complainant makes two objections to this contention of the defendant.

First. That the defendant's rollers *may be* of varying eccentricity, though the variation be so small as to be impossible of detection by the naked eye.

Second. That even though the two rollers of the defendant's lock be not of varying eccentricity, but be absolutely identical, yet that they accomplish *the same result* as do the rollers of varying eccentricity described in the complainant's patent.

I. To say that the defendant's lock *may be* an infringement is to say nothing that is material to support the complainant's case.

If it be uncertain whether the defendant's lock is or is not an infringement, the bill should be dismissed.

The burden of proof was upon the complainant to make out the charge of infringement by preponderating evidence.

If he fails to comply with that requirement he fails in his case.

The authorities are so clear and undoubted upon this point that it is unnecessary to cite them.

Even Mr. H. B. Renwick in substance conceeds that the rollers must, to come within the claim, vary from each other at least to an extent to be detected by a micrometer (p. 9, x-Q. 6). But, as we have seen, not even such variation can be found in defendants' rollers.

Nor would it be sufficient, even though it were proved, that the

defendant's rollers do vary in eccentricity from each other in some infinitesimal manner.

It is proved, beyond dispute, that if there be any variation of eccentricity it is an unintentional variation. And it must assumed that any variation that *may* exist is too minute to be detected even by a micrometor.

The two rollers of the defendants' lock are made by the same tool and at the same time, and with every effort to make them absolutely identical.

The complainant's patent, when it claims a lock provided with two rollers of "varying eccentricity," means that the eccentricity of those rollers should be *intentionally* varied, and also so varied, *at least*, to such an extent as to be discernable.

No one following the specification would attempt to make the rollers alike. The direction of the specification is to make them *un*like.

A person who follows the specification would *not do* what the defendants have done.

The defendants cannot be held as infringers when they have intentionally done and have succeeded, to the best of any person's ability, in doing that which the patent in effect says should *not* be done.

Nor can the structure be converted into an infringing one, because, by accident or use, the rollers become differently worn, so as eventually to vary from each other in eccentricity.

In *Page vs. Ferry*, 1 Fish, 298, the Court said:

"If the original structure was in fact and in truth no infringe-
"ment, neither accident or usage could make it so. Mind must be
"associated with matter in the commission of the trespass. It is
"the intention which gives the guilty hue to the act."

II. Nor will it do for the complainant to contend that even though it be a fact that the defendant's rollers are identical, and are not of varying eccentricity, that the variation of eccentricity is, after all, immaterial, because *the same result* is reached by the use of rollers of the same eccentricity.

To this contention we say:

(*a*) The complainant cannot be heard to allege that the use of rollers "of varying eccentricity" is immaterial.

He has made that feature of construction material by expressly describing it in his claim as *the* feature desired.

The patent not only expressly mentions this peculiarity as a feature of the claim, but the description expressly says that it is "By this means" that the remedy proposed is applied.

In *Fay vs. Cordesman*, 109 U. S., 408, 420, this Court said:

"The claims of the patents sued on in this case are claims for "combinations. In such a claim if the patentee specifies any ele- "ment as entering into the combination, either directly by the "language of the claim or by such a reference to the descriptive "part of the specification as carries such element into the claim, "he makes such element material to the combination, and the "Court cannot declare it to be immaterial. It is his province to "make his own claim and his privilege to restrict it. If it be a "claim to a combination and be restricted to specified elements, all "must be regarded as material, leaving open only the question "whether the omitted device is supplied by an equivalent device or "instrument."

In *Sargent vs. Hall Co.*, 114 U. S., 63, this Court said:

"In patents for combination of mechanisms, limitations and pro- "visos imposed by the inventor, especially such as were introduced "into a specification after it had been persistently rejected, must be "construed as against the inventor and in favor of the public, and "looked upon as in the nature of disclaimers."

(*b*) Nor is it sufficient that the same result should be accomplished by the defendant's machine as by the complainant's. To constitute an infringement, identity of result is not sufficient. The same result must be accomplished by the same means, or substantially the same means.

Case vs. Brown, 2 Wall., 320.
Carver vs. Hyde, 16 Peters, 515.
And numerous other cases.

(*c*) In the present case neither the results nor the means are identical.

The only proof of identity is a *general* statement made by the witness Sargent in answer to a written interrogatory.

He was asked (p. 21):

"Q. 11. In operation and effect as security against picking, what "difference, if any, exists between a pair of disconcerting rollers like "those shown in 'Exhibit Cole, No. 1,' assuming said rollers to

" have been originally made in the manner testified to by the de-
" fendant's witnesses, and a pair of disconcerting rollers made of
" varying eccentricity, as described in the patent in suit No.
" 98,622?"

The witness answers (p. 23, fol. 43):

"A. There would be no difference whatever."

It is to be, perhaps, noted that Sargent does not really mean by this answer to testify that there would be no difference in operation, *if* the rollers were, in fact, of equal eccentricity. His answer must be interpreted, in view of his former answer, in which he expresses an opinion that the rollers, made in the manner described by the defendant's witness, *could not*, "in my judgment," be made exactly alike (Q. 10, p. 21; A. 10, p. 23).

On the other hand the witnesses for the defendant clearly prove a difference in the mode of operation and result.

Mr. E. S. Renwick is asked (p. 19, x-Q. 7): "What would be the
" difference, in your opinion, in practical effect as a security against
" picking, between a pair of disconcerting rollers, both eccentric,
" but both having the same degree of eccentricity, of the same form
" and size, as compared with a pair of disconcerting rollers in which
" the eccentricity of one roller should differ from the eccentricity of
" the other, as you understand to be directed by the patent?"

"A. Practically, I do not know as I have ever known a lock with
" either of the kinds of rollers mentioned in the question to be
" picked; but I am of opinion that that lock, which had the two
" rollers of different eccentricities would be the most difficult to
" pick, because it is within the limit of possibility that two rollers
" of the same eccentricity, size and form might move so as to cor-
" respond exactly, in which case they would operate as a single
" roller, whereas with the other form of the lock this result would
" be absolutely impossible."

And Mr. Towne shows that, under some conditions of use, the identical rollers would operate differently from those of varying eccentricity, and introduce a new element of uncertainty to embarrass picking.

He says (p. 15, fol. 29):

" The action of a pair of rollers constructed in the manner de-
" scribed in complainant's patent would not necessarily be such as
" to produce the desired uncertainty, and I can best illustrate the
" reason of this by means of the accompanying diagram" (he then illustrates and continues).

"The essential difference between the double roller made by us "and that explained in complainant's patent is, that in our device "the two rollers will, from time to time, come into such a position "that their two peripheries will exactly coincide; that they will, "each of them, bear a part of the strain, and that they will revolve "together for a short interval, until some trifling variation in the "periphery of the cam disturbs the equality of the bearing, transfers "the strain to one of them, which will continue to revolve and leave "the other temporarily stationary; whereas, the action of a pair of "rollers, constructed as described in complainant's patent, will, in "all probability, be such as I have above described, and will, for "the reasons I have given, fail to accomplish the desired end.

It will be noticed that Mr. Sargent was examined *subsequent* to the above testimony of Mr. Towne and of Mr. E. S. Renwick, and it will be also noticed that Mr. H. B. Renwick, the complainant's expert, was not recalled, and that no attempt was made to contradict or explain the evidence given, which was to the effect that the identical rollers differ in mode of operation and result from the Sargent rollers of varying eccentricity; under some circumstances being less, and under others more effective.

It cannot, therefore, be said that the difference of form, so expressly claimed, are immaterial or that the results are the same.

There was, therefore, for all the reasons above cited, no infringement, and the bill should have been dismissed.

SECOND POINT.

The above conclusion is strengthened by the fact that the Yale Identical Double Roller Lock was invented prior to the date of Sargent's patent.

Sargent's patent is dated January 4, 1870.

The date of application for the patent is not proved, and, in the absence of such proof, it is presumed to be of the same date as the patent.

As to the time of the adoption of the double rollers Mr. Towne says (p. 12, A. 3):

"In the autumn of 1870 we made a series of experiments on dis-
" concerting devices. The double eccentric roller referred to prov-
" ing to be the best adapted to our wants, was adopted, and I gave
" the necessary instructions for the manufacture of these rollers,
" and for their application to locks made by us."

And (p. 13, A. 6):

"Our bank lock department is in charge of Mr. Emory Stock-
" well, as foreman, and the locks and all parts thereof were made
" under his immediate supervision. He participated in the experi-
" ments which I have above referred to, and the disconcerting de-
" vice which we adopted was of his invention."

On the accounting before the Master the following more specific evidence was given by Mr. Towne (Record No. 164, p. 218).

"The double roller covered by the patent forming the basis of
" suit No. 2 was never, to my knowledge, used in any of the Sargent
" locks. As I before testified, it was invented by Emory Stockwell,
" and introduced by him in the Yale Bank Lock. Some months
" subsequent to this James Sargent, the complainant, applied for
" and obtained a patent for the device, but the device, as patented,
" was not in form applicable to the Sargent & Greenleaf locks,
" and, I believe, was never used in them. It was subsequently shown
" to be of little value, and was abandoned by the Yale Lock Com-
" pany."

"At the time of the issue of the injunction in these suits, the
" defendants were not using the double-roller device involved in
" suit No. 2, and their business was therefore unaffected by the in-
" junction."

And again (No. 164, p. 210, fol. 355):

"At the time this device was thus adopted it was not covered
" by letters patent, and the Yale Lock Company, fully believing it
" to be the invention of Emory Stockwell, and having his consent
" thereto, believed themselves perfectly free to use the device."

This evidence was repeated at another part of the record (Record No. 164, p. 209), but was then erroneously excluded by the Master.

It was not then offered to attempt to prove the prior invention of Stockwell (for which purpose, at that stage of the case, it was probably incompetent), but to prove that the device was adopted *in good faith* by the defendant, prior to any patent of Sargent's, and without any notice of his claim, though shown to him. This good

faith of defendant was both material and competent in considering the question of damages.

Presumptions and liberality of assessment may be indulged against a defendant acting in bad faith, but not against one who, like defendant, adopted, prior to complainant's patent, an original invention of their own employee.

This evidence, which was then properly placed before the Master, for one purpose, may now, when the question of infringement is again open for discussion, be considered on that issue, and it is clear that the adoption of the device complained of, prior to the date of the patent sued on, is persuasive evidence that such patent was not intended to include it, but must be restricted to its own peculiar phraseology, and that it cannot legally include it.

THIRD POINT.

The Master's Report was Incorrect.

In considering the question of profits and damages, the facts relating to the adoption and use of the double roller must be noted.

The Master narrates them as follows in his report (p. 27, fol. 56): "The facts in this case are peculiar. In the summer of 1869, "at a time and place agreed upon, the complainant Sargent picked, "with the aid of a micrometer, one of the defendant's locks in a "safe, and opened the safe. This picking immediately became "known to the general public, and particularly that portion of it "interested in safe locks."

"The natural result of such picking was that the defendant's "locks were greatly damaged in their commercial value, and would "have become unsalable had not some device been discovered to "protect it."

"Shortly after this the complainant Sargent invented and pat-"ented a device ('The Double Roller') to prevent this picking of "defendant's locks by the use of a micrometer, and this accounting "is upon this patent."

"The device so discovered by the complainant was of no use or "benefit to him in the manufacture of his own locks; nor was it of

"any use or benefit to any manufacturers of locks other than this "defendant corporation."

This statement should, however, be supplemented by the following facts:

(*a*) The liability to picking in a lock by the use of a micrometer is a wholly *theoretical* defect. No lock was ever known to be picked *surreptitiously* by the use of a micrometer. Mr. Towne says (Record, 164, p. 211):

"I am aware that it is believed that the double roller was a pro- "tection against micrometer picking, but this is only one of the "means of picking combination locks, and is the one least to be "feared in actual use, since it requires the possession of delicate "instruments, skill, coolness, quiet and ample time to make it "available as against a lock of mere ordinary construction. No "lock has ever been picked by this means by burglars, nor do I be- "lieve that such could ever be done."

Mr. Sargent himself admits (No. 164, p. 142, fol. 244):

"Q. Did you ever know of a case of a bank lock having been "picked by a burglar with micrometer?

"A. I do not."

(*b*) Nor did the adoption of the double roller render the Yale lock secure.

It was again picked by Sargent by other instrumentalities, and the double roller, therefore, was shown to be inefficient.

Mr. Towne says (Record, 164, p. 211, fol. 356):

"In the month of August, 1870, one of the locks containing this "device was furnished by the Yale Lock Company to Sargent & "Greenleaf for experimental purposes. The result of the experi- "ment then made demonstrated that the lock was still pickable; "and, in consequence thereof, the double roller device, which had "thus proved insufficient to give entire protection to the lock "against picking, was abandoned, and in its stead was substituted "the device now used in the Yale bank lock, and which is de- "scribed in the patent of Stockwell, before referred to, dated July "25th, 1871."

And again (fol. 357):

"The value of the double roller device to the Yale Lock Com- "pany was, therefore, small. It was used but a short time, and

" failed utterly to accomplish the desired object, viz., the protec-
" tion of the lock against picking."

On the above indisputable and undisputed facts we note the following errors in the report:

(*a*) *On the face of the Master's Report he should have allowed nothing, and the Court erred in allowing anything on the basis followed by the Master.*

The Master said (Report p. 27, fol. 56): "The device so dis-
" covered by the complainant was of no use or benefit to him in the
" manufacture of his own locks, nor was it of any use or benefit to
" any manufacturer of locks, other than this defendant corporation.

" It does not appear that Sargent ever parted with his patent
" or any interest in it, or granted any license under it."

" *It is not a question of damages,* for the complainant did not
" make or sell or license others to use his invention."

" *It is not a question of profits* because *none have been shown as*
" *such.*"

This part of the report *was not excepted to.* It therefore stands *indisputable.*

The law only allows a patentee to recover either "profits" or "damages" (R. S., § 4921).

His powers, and those of the Court were limited. There was no authority to find out, on some principle of ideal justice, what would be a fair "compensation" to make the defendant pay, for something which they had not damaged the complainant in using, and from which they realized no "profits" as such; (in fact a *loss* was made on all these locks (Rec., 164, p. 164, fol. 280); which had no distinctive value in itself because it failed of its purpose, and whose only value to the defendant, at all, was *not inherent in it as an invention,* but simply as a basis to advertise to their customers that they had adopted *something* to remedy defects which were not harmful *in themselves* (because no lock was ever picked by a micrometer), but simply because publicity had been given them by Sargent's *advertisements.*

Mr. Towne says (Rec., 164, fol. 84, Q. 15):

" The introduction of *some* protecting device was necessary, but
" not necessarily of a disconcerter."

And again (Q. 16):

" I think that our agents and customers would have accepted

" our assurances as to *any change* that we had made in the lock " being sufficient to make it secure."

The Master having found both points which were expressly referred to him by the decree in favor of the defendant, *his report should there have stopped.* But after finding that *neither damages nor profits* were shown, he goes on to award in favor of the plaintiff and against the defendant a recovery which he denominates " a compensation." He correctly holds that, " It is well settled that neither " profits nor damages can be estimated; they must be calculated." But notwithstanding this ruling he goes on to *estimate* the " compensation " due the complainant by awarding, as such compensation, not the value of the complainant's device, but the amount of royalty paid by the defendant to one Emory Stockwell for an entirely different device, and one which, it was shown, *was much superior to the complainant's.*

(b) *The proof as to the royalty paid Emory Stockwell for a* DIFFERENT *and* SUPERIOR *form of protection was not competent evidence to measure the value of Sargent's device.*

This evidence was introduced to contradict the extravagant estimates of complainant's witnesses, who stated the value at $10.00 and $5.00 per lock.

Mr. Towne says as to the device (Rec. 164,, p. 214, fol. 362):

" After the inutility of the double roller device as a protection " against picking was demonstrated in 1870, the Yale Lock Manu- " facturing Company adopted for use in all of its bank locks, the " eccentric ' fence rollers,' described in the Stockwell patent of July " 25, 1871. In consideration for this use of said patented devices " the Yale Lock Manufacturing Company paid to said Stockwell the " following royalties, viz.:

" On the double-dial lock, per lock	$1 00
" On the No. 1 (Old No. 2), per lock	75
" On the No. 3, per lock	50

" This device proved a perfect protection against the mode of " picking discovered in 1870, and is equally effective as against mi- " crometer picking. It is in use to-day in the Yale bank locks, and " has proved to be a perfect device for its intended purpose."

The patent for this device is found at p. 208 (Rec., 164), and the Court will observe that it contains SIX claims.

Mr. Towne testifies that this patent not only embodies a substitute for the double roller, but also for the "turning bolt" (of suit No. 164).

He says (p. 208, fol. 350) :

"In seeking a substitute for the bolting device, used in the Yale "fire-proof lock, which should not infringe the Sargent round-bolt "patent, recourse could be had to the ordinary form of sliding bolt, "and in anticipation of needing a lock of this kind provided with a "sliding bolt, experiments were made by Emery Stockwell, who "was in the employ of the Yale Lock Company, by instruction of "the company and at its expense, to adapt a sliding bolt to the "Yale fire-proof safe locks. Several plans for accomplishing this "were proposed, but the one which seemed best was that illustrated "and described in Letters Patent No. 117,478, dated July 25th, "1871, and granted to the said Emory Stockwell. A license under "this patent was obtained by the Yale Lock Company, and a suffi-"cient number of locks made in accordance with it to demonstrate "the entire feasibility of the arrangement."

The question presented, therefore, is whether evidence of the license to use this *much more important* invention is competent evidence, at all, of the value of Sargent's inferior device, merely because *one* feature of the superior device can be utilized for the same purpose as the inferior device.

We submit that it is clear that it is not.

If A is sued in trespass for injuring B's mule, evidence cannot be introduced of the value of a horse, sometimes used for the same purpose.

And in patent causes it has been several times decided that, when an infringer is sued for infringing a single claim of a patent, which has several, evidence of license fees paid for the right to use *all* the claims is incompetent to fix the value of *one*.

Westcott vs. Rude, 19 Fed. Rep., 830 (WOODS, J.).
Wooster vs. Simonson, 16 Fed. Rep., 680 (WALLACE, J.).
Proctor vs. Brill, 4 Fed. Rep., 415 (BUTLER, J.).

Much more is this true when the license fee sought to be enforced is not one received under the patent in suit, but under a different one.

(c) *The complainant cannot recover the whole value of any device which would accomplish the purpose of the patented device.*

He can in any event only recover, as profit, the benefit or advantage which the defendant derived from using the complainant's invention *over* what he had, in using other devices or processes then open to him, and adequate to enable him to obtain an equally beneficial result. This is the rule expressly laid down in *Mowry vs. Whitney*, 14 Wallace, 620, and has been re-affirmed in Cawood Patent, 94 U. S., 710, and *Mes vs. Cawood*, 11 Off. Gaz., 1,111.

It is shown in the evidence that during the whole period of the alleged infringement, the defendants were licensed under the "Butterworth patent," which embodied a device called the "flying talon," which would accomplish precisely the same result as the Sargent double roller (pp. 108, 109).

The only possible way, therefore, in which the complainant could show any value of this device, which could be recovered against the defendants, was to show the value either in cheapness, efficiency or in other respects, of the Sargent "double roller" over the Butterworth "flying talon," for the same purpose. No such proof was attempted, and consequently there was no proof on which the Master could base any finding.

Instead of that, he adopted as a basis, the whole royalty claimed for an entirely different device, which was at least twice as valuable, and then committed the further error of doubling that royalty on a mere matter of "belief," utterly unfounded in the proofs.

The exceptions should be sustained and decree reversed.

FREDERIC H. BETTS,
Counsel for Appellant.

[illegible]

Supreme Court

[illegible]

The Yale Lock [illegible]

Appellant,

vs.

James Sargent,

Appellee.

APPEAL FROM THE CIRCUIT COURT OF THE
STATES FOR THE SOUTHERN DISTRICT

BRIEF FOR THE APPELLEE

GEO. [illegible]
EDWARD [illegible]
Of Counsel for the Appellee

[illegible]

Supreme Court of the United States.

OCTOBER TERM, 1885.

THE YALE LOCK MANUFACTURING COMPANY, *Appellant*,

vs.

JAMES SARGENT.

No. 165.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR THE SOUTHERN DISTRICT OF N. Y.

BRIEF FOR THE APPELLEE.

GEO. TICKNOR CURTIS,
EDWARD WETMORE,
Of Counsel for the Appellee.

The assignment of errors in this case sets forth—

1st. The Court erred in decreeing that the defendants had infringed the Sargent patent.

2d. The Court erred in not holding that the devices and arrangement of the defendant's lock were adopted prior to the date of Sargent's patent, and prior to any date of invention proved by him, and that such devices could not be legally included in the patent.

3d. The Court erred in confirming the Master's report and adjudging any recovery to the complainant.

(*a*) Because on the face of the report the Master found that neither profits or damages were proved.

(*b*) Because there was no authority by statute, or otherwise, to award "compensation" to a plaintiff where neither "profits" nor "damages" were shown.

(*c*) Because there was no *competent* evidence before the Master upon which to base any recovery.

4th. The Court erred in rendering any decree in favor of the complainant.

The patent in suit was granted to James Sargent, complainant, January 4th, 1870, No. 98,622, and is what is known as the "Double Roller Patent."

The specification sets forth that the lock described therein, is "an improvement upon that of Linus Yale, in which an eccentric roller is combined with the cam for disconcerting the action upon the tumblers."

This form of lock, with a single disconcerting roller, was picked by complainant, by the use of a micrometer (Record, p. 23, folio 43,) which led, as has been stated by the Master in his report, to great damage of the commercial value of said locks, which "would have become unsaleable had not some device been discovered to protect it." (Record, p. 27, folio 56.)

The result of these events was the lock invented by complainant Sargent, which "consists in combining with the cam an arrangement of two or more eccentric rollers of varying eccentricity, turning upon the same bearing, so that, in revolving, one or both may turn or alternate in action, thereby greatly increasing the difficulty of mapping out, or locating, the position of either." (Specification, complainant's patent.)

It appears from the proofs, and is not denied by the defendant, that the infringing lock (Exhibit Cole No. 1,) has two disconcerting rollers, in combination with a cam, on which they ride. (Renwick test'y, Rec. p. 8.) The one feature which enters specifically into the claim of the patent in suit, and which is said not to be found in the defendant's lock, is the "varying eccentricity" of the disconcerting rollers.

Upon this point conflicting statements are found in the testimony. Upon the one side, Mr. Towne, president of the defendant Company, says, that the rollers used in the defendant's lock are not of varying eccentricity. (Rec., p. 13, Q. 5.) And Mr. Stockwell, superintendent of the Company, swears that the disconcerting rollers in defendant's lock were placed together upon an eccentric chuck, and both turned up to the required shape. (Rec., p. 16, Q. 4–5–6.)

The matter is capable, however, of a clear and simple demonstration. If two rollers, turned out together and in the manner described by Mr. Stockwell, have their axes located at different points in the same diameter, it is evident that they will be of "varying eccentricity." Upon this point Mr. Renwick testifies, (Rec., p. 9, folio 20.)—

> "I have examined the patent and believe that the words 'varying eccentricity,' as applied to the rollers, mean that the rollers shall have their axes at different points in their diameters. If the two rollers be each $\frac{3}{4}$ of an inch in diameter, and one have its axis 35–1,000 of an inch from the nearest point in its periphery, and the other have its axis 40–1,000 of an inch from the nearest point of its periphery, then they will be of varying eccentricity. This variation of distance of the axis from the nearest point of the periphery need be no greater than the smallest distance that can be measured by the sensitive micro-

meters used in lock-picking, for the reason that the whole aim of the patented contrivance is to avoid picking by means of a micrometer."

Such construction, evidently, would be within the terms of the complainant's patent.

But it is submitted that two rollers each having the same eccentricity and independently mounted upon the same axis, is a construction within the terms of complainant's patent, because as each roller is free to turn separately their positions relatively to each other and to the cam are constantly changing, and the eccentricity of the roller series, as a whole, is constantly varying relatively to the cam, and this is the exact purpose of the employment of two or more rollers instead of one.

The testimony of Mr. Towne, president of the defendant company, is valuable in this connection.

He says (Rec., p. 14, folio 28, 29):

"The disconcerting rollers, as originally used, consisted of a single eccentric disk resting on the periphery of a cam, the object of its eccentricity being to introduce an element of uncertainty between the fence, or dog, and the operating spindle of the lock, so that in an attempt to pick the lock by means of a micrometer, this eccentricity being variable and uncertain, would disconcert any one attempting to measure the point of contact of the fence with the tumblers. It was eventually discovered, however, that with a *single* eccentric roller the desired uncertainty was not obtained; that by carefully rotating the cam two points, one on the cam and the other on the roller, which at a given time might be in juxtaposition, could be readily returned to the same position, providing only that a correct record was kept of the revolutions or parts of revolutions through which the cam might be moved, and that these motions of the cam were repeated in a reverse direction. In other words, the cam and roller operated together substantially as

would two spur gears of similar diameters. It will be seen, therefore, that the relative positions of the cam and roller were positive instead of variable, and the desired uncertainity in their relative positions not obtained. Locks constructed on this principle have been picked, thereby demonstrating the uselessness of the device and the fallacy of the principle upon which it was constructed. The double disconcerting roller made and used by us overcame this difficulty. *The action of a pair of eccentric rollers*, each of which is identical with the other in shape and eccentricity, revolving upon the periphery of a cam, was found by experiment to be in the highest degree variable and uncertain. As the cam was revolved sometimes one roller would turn (the other remaining stationary) and sometimes the other, while at other times the two rollers having been rotated to a point at which their peripheries exactly coincided, both would revolve together for a short period until some slight impediment, or change in the periphery of the cam, would cause one to bear more directly than the other upon the periphery of the cam, when this one would revolve with the cam, the other remaining stationary, and so on In this way a perfect disconcerter was obtained which would effectually baffle any attempts to measure the point of contact of the fence with the tumblers." * * *

"The essential difference between the double roller made by us and that explained in complainant's patent is, thatin our device the two rollers will, from time to time, come into such a position that their two peripheries will exactly coincide; that they will, each of them, bear a part of the strain, and that they will revolve together for a short interval, until some trifling variation in the periphery of the cam disturbs the equality of the bearing, transfers the strain to one of them which will continue to revolve and leave the other stationary, whereas, the action of a pair of rollers, constructed as described in complainant's patent, will, *in all probability*, be such as I have described above, and will, for the reasons I have given, fail to accomplish the desire end."

Turning now to the language of complainant's patent, we find in the body of the specification the following:

> "The several rollers strike at different positions, and when one touches, the other may be removed from contact, thus alternating in action. They may also turn in different directions. By this means, owing to the different contact of the several rollers, the difficulty of mapping out and locating the same is very greatly increased.
>
> "*In transferring the action from one roller to the next the loss of contact with the first disarranges the position, and thus renders it indefinite. In this manner, and for this reason, the addition of another roller to the one already in use does not produce an accumulation of the same effect in action, but produces a different action altogether, by breaking the continuity of rotation and movement and contact*
>
> "I disclaim the employment of a single eccentric; but—
>
> "What I claim as my invention, and desire to secure by Letters Patent, is—
>
> "The arrangement of two or more rollers, H H', of varying eccentricity, when combined with the cam, in the manner and for the purpose specified."

Nothing can be plainer than the fact that the action of the disconcerting rollers, described by the witness, Towne, is identical with that proposed in the patent.

What objections might arise from a gross or absurd exaggeration of the eccentricity of the one roller, as compared with that of the other, it is impossible to say, and unnecessary to consider. It is a matter capable of demonstration, from the drawings of the Sargent patent, that the two rollers must, at times, revolve together, and that each will then sustain a part of the strain; that the continuity of rotation of each will be broken alternately with that of the other, and that the real gist of complainant's invention is found, as clearly set forth in his

specification, to consist in the employment of *two* rollers, having each an eccentricty, which *constantly varies so far as relates to the cam upon which they bear.*

The sole purpose of giving a different eccentricity to the rollers is to secure the alternation in action, by breaking the continuity of rotation, movement, and contact. It is impossible to deny that the defendant's lock accomplishes this result by the same means, operating in the same manner.

The theory that rollers of the same eccentricity, mounted to rotate separately on the same bearing, and therefore, sustaining a *constantly varying* eccentricity *with relation to the cam*, is an invention not within the purview of complainant's patent, is, in effect, a subversion of the plainest rules of construction, and an attempt to convert a most palpable colorable evasion into a material and important distinction.

The construction of the claim of complainant's patent for which we contend is plainly warranted by that portion of the description quoted above, and italicised.

SECOND.

As to the second point in the assignment of error, we submit that no competent evidence was adduced before the Court below showing an invention by Stockwell prior to the date of Sargents patent. The only testimony to this effect was given before the master in another and different cause (record, case 164, p. 218,) and was properly excluded by him. The only proof touching the point which was adduced in the present case was that of Mr. Towne (Rec. p. 12, folio 25,) who says :

> "In the *autumn of* 1870 we made a series of experiments on disconcerting devices. The double eccentric roller referred to proving to be the best

> adapted to our wants was adopted, and I gave the necessary instructions for the manufacture of these rollers and for their application to locks made by us."

The date thus assigned for the production of the double identical roller was nearly a year after the issue of the patent in suit, and the evident inconsistency in dates given should render the testimony worthless for all purposes of proof. Moreover, the statement of the witness Towne, given in the record of case 164, p. 218, alluded to above, gives no specific date whatever, of any alleged invention by Stockwell, and even were such proof competent in the present instance, it must wholly fail for uncertainty.

THE RULING OF THE COURT BELOW, SUSTAINING THE MASTER'S REPORT, WAS CORRECT.

This case was peculiar in this: The only possible measure of damages was the value of the invention, and its value consisted in its special adaptability to the defendant's lock. No one else used it, and there was no license fee established for its use. The defendant, who should have been a licensee, simply appropriated it.

The point is taken that because the Master found that there were no data from which he could compute the profits to the defendant of the infringement, it necessarily follows that there is no evidence from which it can be found that the invention was of any pecuniary value to the defendant.

This is fallacious. The facts showed that the defendant's lock having been publicly picked for the want of such a device as that furnished by the invention, its locks became unsalable, until such a device should be found. Sargent's invention first supplied this want, and was the only thing that could do so until the subsequent invention of Stockwell. It might, therefore, be claimed with much

force that, during the interval that preceded Stockwell's invention, the profits due to the infringement were the whole profits of the lock—for, except for the infringement, the defendant could not have sold the lock.

Such an estimate of the profits, however, would be excessive and based on a wrong principle, because it would give the whole profit of the lock to every patented feature it contained which was essential to its organization, and it might contain several such features.

The Master, therefore, correctly found that he could not apportion the profit due to the invention from the *mere* circumstances of its essential character.

As the defendant paid Stockwell, its own employee, the moderate sum of one dollar per lock for his invention, which was a substitute for the pirated invention, and as that sum, in view of Stockwell's relation to and arrangement with the defendant, was, presumably, less than the defendant would have been obliged to pay to a stranger for the same thing, the Master found that the pirated invention was worth to the defendant, at least, one dollar per lock. In view of the fact that the invention was absolutely essential to the defendant, this finding was most moderate, amounting in all to about $400.

The Master found this as "damages." It is immaterial what name be given to the sum so found, for it is a case where damages and profits are identical. It represents the value of the invention to the defendant, who wrongfully appropriated it, and that sum the law gives as compensation to the injured party.

The learned Justice, in his opinion in the Court below, correctly stated the law, as follows:

> "The Master was right in reporting a compensa-
> " tion to the plaintiff. Such compensation was either
> " damages to the plaintiff or advantages to the de-
> " fendant. It was the value of the use of the inven-